

APPENDIX A

ANTI-MONOPOLY, INC.,
Plaintiff and Counter-Defendant-Appellant,

v.

GENERAL MILLS FUN GROUP, INC.,
Defendant and Counter-Claimant-Appellee.

No. 81-4281.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted Nov. 9, 1981.

Decided Aug. 26, 1982.

Plaintiff, corporation engaged in business of selling game called Anti-Monopoly, brought action to challenge validity and enforceability of "Monopoly" trademark. On remand after prior appeal, 611 F.2d 296, the United States District Court for the Northern District of California, Spencer Williams, J., found for the defendant trademark owner, 515 F.Supp. 448. On second appeal, the Court of Appeals, Duniway, Circuit Judge, held that: (1) the District Court's finding that, as game trademark, "Monopoly" primarily denoted its producer was clearly erroneous, and (2) as applied to board game, the word "Monopoly" had become "generic," and register of it as trademark was no longer valid.

Reversed and remanded.

Carl E. Person, New York City, for Anti-Monopoly, Inc.

Robert S. Daggett, San Francisco, Cal., argued, for General Mills Fun Group, Inc.; Oliver P. Howes, Jr., Nims, Howes, Collison & Isner, New York City, Brobeck, Phleger & Harrison, San Francisco, Cal., on brief.

Appeal from the United States District Court for the Northern District of California.

Before DUNIWAY and SNEED, Circuit Judges, and TASHIMA,* District Judge.

DUNIWAY, Circuit Judge:

This is the second appeal in this case. Our first opinion is reported in *Anti-Monopoly, Inc. v. General Mills Fun Group*, 9 Cir., 1979, 611 F.2d 296 (*Anti-Monopoly I*). On remand the district court again found that the "Monopoly" trademark was valid and had been infringed by Anti-Monopoly, Inc. *Anti-Monopoly, Inc. v. General Mills Fund Group, Inc.*, N.D.Cal., 1981, 515 F.Supp. 448 (*Anti-Monopoly II*). We reverse and remand for further proceedings.

I. Prior Proceedings.

General Mills is the successor to Parker Brothers, Inc., which had produced and sold a game it called Monopoly since 1935. Parker Brothers registered "Monopoly" as a trademark in that year. In 1973 Anti-Monopoly, Inc. was established to produce and sell a game it called Anti-Monopoly. General Mills claimed that this infringed its trademark. This action was then brought by Anti-Monopoly, seeking a declaratory judgment that the registered trademark "Monopoly" was invalid, and cancelling its registration. In a counterclaim, General Mills sought declaratory and injunctive relief upholding its trademark, and the dismissal of the action. The case was tried without a jury in 1976. The court entered a judgment for General Mills. We reversed and remanded for further consideration of (i) the validity of the trademark, (ii) infringement of the trademark, if it is valid, by Anti-Monopoly, and (iii) state law claims concerning unfair competition and dilution. We also chose to deter consideration of (iv) Anti-Monopoly's defense that General Mills had unclean hands. On remand, after hearing further evidence, the district court again entered a judgment for General Mills.

*The Honorable A. Wallace Tashima, United States District Judge for the Central District of California, sitting by designation.

II. The Standard of Review.

We state the standard of review at the beginning of this opinion, lest we be charged with not applying it because our "acknowledgement [of it] came late in [our] opinion." *Pullman-Standard v. Swint*, 1982, ____ U.S. ____, at ____, 102 S.Ct. 1781, at 1791, 72 L.Ed.2d 66; *id.*, Marshall, J., dissenting, at ____, 102 S.Ct. at 1784-85.

We must apply the standard stated in Rule 52(a), F.R.Civ.P., the case having been tried without a jury: "Findings of fact shall not be set aside unless clearly erroneous, . . ." This has been interpreted to mean that the trial judge's finding of fact cannot be set aside unless, "although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *Unites States v. United States Gypsum Co.*, 1948, 333 U.S. 364, 395, 68 S.Ct. 525, 542, 92 L.Ed. 746.

The Supreme Court has recently reminded us of the importance of the rule and of our duty to abide by it. *Pullman-Standard, supra*, ____ U.S. at ____, 102 S.Ct. at 1789. In that case, the Court held that the rule applies equally to "ultimate" facts and to "subsidiary" facts. (*Id.*). The Court also held that, when a finding is based on an erroneous view of the law, it may be set aside, but that in such a case the appellate court cannot make a contrary finding, but must remand to the trial court for new findings, to be made in the light of the correct rule of law. (*Id.* at ____, 102 S.Ct. at 1791-92). To this there is one exception: A remand is unnecessary if "the record permits only one resolution of the factual issue." (*Id.*, citing *Kelley v. Southern Pacific Co.*, 1974, 419 U.S. 318, 331-332, 95 S.Ct. 472, 479-80, 42 L.Ed.2d 498.) See also *Inwood Laboratories v. Ives Laboratories*, 1982, ____ U.S. ____, ____, 102 S.Ct. 2182, 2188-90, 73 L.Ed.2d ____, and the concurrence of Justice Rehnquist:

I also assume, correctly I hope, that the Court's discussion of appellate review of trial court findings in bench trials, *ante*, at ____, is limited to cases in which the appellate court has not found the trial court findings to be "clearly erroneous." *United States v. United States Gyp-*

sum Co., 333 U.S. 364 [68 S.Ct. 525, 92 L.Ed. 746] (1948), upon which the Court relies, establishes the authority of a reviewing court to make its own findings, contrary to those of the trial court, where it has determined the latter to be "clearly erroneous." (____ U.S. at ____ ____, 102 S.Ct. at 2193.)

III. *The Burden of Proof.*

The district court ruled that Anti-Monopoly had the burden of showing genericness "by convincing evidence." *Anti-Monopoly II*, 515 F.Supp. at 451-452. The case cited for that proposition, *Feathercombs, Inc. v. Solo Products Corp.*, 2 Cir., 1962, 306 F.2d 251, does not announce such a rule. The only reference to "convincing evidence" is at 306 F.2d 256, and says nothing about burden of proof. There is a presumption in favor of a registered trademark, and the burden of proof is upon one who attacks the mark as generic, but the presumption can be overcome by a showing by a preponderance of the evidence that the term was or has become generic. See *Vuitton et Fils S. A. v. J. Young Enterprises*, 9 Cir., 1981, 644 F.2d 769, 775-776.

IV. *Generic Terms—The Law.*

Our opinion in *Anti-Monopoly I* binds both this court and the district court. There, we set out the law about generic terms and explained how it was to be applied to the particular facts of this case. *Anti-Monopoly I*, 611 F.2d at 300-306. In this opinion, we assume that the reader will be familiar with that opinion. Here, we emphasize what we consider to be its essence. A word used as a trademark is not generic if "the primary significance of the term in the minds of the consuming public is not the product but the producer." *Id.* at 302. "[W]hen a trademark primarily denotes a product, not the product's producer, the trademark is lost." *Id.* at 301. A registered mark is to be cancelled if it has become "the common descriptive name of an article," 15 U.S.C. § 1064(c), and no incontestable right can be acquired in such a mark. 15 U.S.C. § 1065(4). We said "Even if only one producer—Parker Brothers—has ever made

the MONOPOLY game, so that the public necessarily associates the product with that particular producer, the trademark is invalid unless source indication is its primary significance." *Anti-Monopoly I*, 611 F.2d at 302. "It is the source-denoting function which trademark laws protect, and nothing more." *Id.* at 301. "[O]ne competitor will not be permitted to impoverish the language of commerce by preventing his fellows from fairly describing their own goods." *Id.*, quoting *Bada Co. v. Montgomery Ward & Co.*, 9 Cir., 1970, 426 F.2d 8, 11. "[W]hen members of the consuming public use a game name to denote the game itself, and not its producer, the trademark is generic and, therefore, invalid." *Id.* at 304.

V. Was the Term "MONOPOLY" Generic at the Time of Registration?

Anti-Monopoly, Inc. claims that the term "Monopoly" was generic at the time when Parker Brothers registered it. On this question, the trial judge made the following findings:

Plaintiff [Anti-Monopoly] attempted to show at trial that at the time of Parker Brothers' trademark registration, MONOPOLY was already a widely played game known by that name. The evidence introduced to support this contention consists chiefly of isolated and sporadic examples of individuals playing old oilcloth games referred to in some instances as "Monopoly," the "Landlord's Game," or some other variation thereof.

* * * * *

In order to be "generic," the name MONOPOLY, in the minds of the consuming public, must primarily denote product rather than source. It remains unclear how widely played the precursors to modern MONOPOLY were in the 1920s and early '30s. Plaintiff has simply made no showing as to what the public conception of the term was at that juncture or indeed how widely played it actually was. As Clarence [sic] Darrow, and later his successor, Parker Brothers, popularized a specific game they called MONOPOLY, this court cannot find that the trademark when registered denoted "a game" rather than the "game's producer." Because Anti-Monopoly has the bur-

den of showing genericness by convincing evidence, *Feathercombs, Inc. v. Solo Products Corporation*, 306 F.2d 251 (2d Cir. 1962), this finding must be for defendant.

515 F.Supp. at 451-452. The district court found also that Darrow was the inventor of the game (*Id.* at 451) and that the game was "created" by Darrow. *Id.* at 452 n.1. (The quotation marks are in the original.)

We have already held that the district court placed too heavy a burden on Anti-Monopoly, Inc. Moreover, the court's reference to Darrow as the inventor or creator of the game is clearly erroneous. The record shows, as we stated in *Anti-Monopoly I*, that "The game of 'Monopoly' was first played from 1920 to 1932 on various college campuses by a small group of individuals, many of whom were related by blood or marriage. In late 1932 or early 1933 one of these players introduced Charles Darrow to the game, and gave him a handmade game board, rules, and associated equipment. Immediately thereafter Darrow commenced commercially producing and selling 'Monopoly' game equipment." 611 F.2d at 299.

We have re-examined the entire record on appeal. Here is what it shows. At some time between 1904 and 1934, the game of monopoly developed. Early equipment was handmade and copied from earlier handmade equipment. All the witnesses presented by Anti-Monopoly insisted that the game was known as "Monopoly" by all who played it, although in most cases the name did not appear on the board itself. The game was played in Reading, Pennsylvania, sometime between 1911 and 1917, but this date may be a little early. In the early 1920's the game was played in Princeton University, Massachusetts Institute of Technology, Smith College, the University of Pennsylvania, and Haverford College. On occasion the rules were privately printed. The game was offered to, but rejected by, Milton-Bradley, a leading competitor of Parker Brothers. It was played in and around Reading, Pennsylvania from the early 1920's to the early 1930's. It may have been brought there from the University of Pennsylvania. Players in Reading made up and sold some half dozen sets of equipment at Williams

College and the University of Michigan. The game next appeared in Indianapolis, where some players marketed it under the name "Finance." (Players in Reading sold some of those games too.) The game of monopoly was brought to Atlantic City, New Jersey in 1931 or thereabouts. The street names used in the game were then changed to Atlantic City street names. The game was taught to Darrow. He sold it to Parker Brothers in 1935, claiming that it was his own invention. Parker Brothers also bought the Finance game from its owners.

It is true that Darrow, in his correspondence with Parker Brothers, claimed to have invented the game and offered to sign an affidavit stating his story. However, Robert B. M. Barton, the former President of Parker Brothers, who negotiated with Darrow in 1935, testified that he did not believe Darrow's claim. A precursor of monopoly, the Landlord's Game, was patented by Mrs. Maggie Elizabeth Phillips of Washington, D.C. in 1904 and again in 1924. Parker Brothers purchased this game from her in 1934 or thereabouts.

In 1957, Barton, the President of Parker Brothers, in a letter to an inquirer, wrote: "So far as we know The Landlord's Game, invented by Mrs. Elizabeth Maggie Phillips of Washington, D.C., was the basic game for both FINANCE and MONOPOLY. Mrs. Phillips patented her game and we purchased her patent. Mr. Charles Darrow later made many improvements in The Landlord's Game and called his game MONOPOLY. He, too, secured a patent which he assigned to us. Because of the fact that we purchased all three games, it does not make very much difference to us who invented either one of the games. . . ."

The evidence clearly shows that the game of monopoly was played by a small number of people before Darrow learned of it, and that these people called the game "monopoly." It is unclear just how many people played. General Mills offered testimony that it was not widespread throughout the United States. The burden of proof was on Anti-Monopoly to show that the term was generic. We cannot presume that the evidence offered by

Anti-Monopoly is the tip of the iceberg. Thus, we are faced with the following legal question: if a game is known about by a small number of people and they all call it by a particular term, may one member of the group appropriate that name by registering it as a trademark?

Ordinarily, because the trial judge imposed too heavy a burden on Anti-Monopoly, we would be required to remand for new findings made under the proper burden. However, because we have concluded that the evidence, construed most favorably to Anti-Monopoly, does not show that "Monopoly" had become generic before Parker Brothers registered it as its trademark, and because our holding in Part VI, *post*, is dispositive of the case, such a remand is unnecessary here.

When a small number of people use a particular thing and call it by a particular name, one which is not a common descriptive term for the thing, a person may appropriate the name and register it as a trademark. The purpose of the doctrine that generic terms cannot be made trademarks is to prevent the appropriation of a term that is already in wide use among those who are potential purchasers of the thing that the term describes. If those who might purchase the thing know it by a particular name, then to forbid the use of that name by potential producers will erect unwarranted barriers to competition. As we said in *Anti-Monopoly I*, "Trademarks . . . are not properly used as patent substitutes to further or perpetuate product monopolies," 611 F.2d at 300. On the other hand, where, as here, the potential market is nationwide, and where the name is used only by a small number of scattered consumers, appropriation of the name as the trademark of one who produces for that potential market does not restrain competition to a significant degree.

We agree with the trial judge's conclusion that "Monopoly" had not become generic before Parker Brothers registered it as a trademark.

VI. Has "Monopoly" Become Generic Since It Was Registered?

This question is discussed, and the trial court's findings of fact appear in *Monopoly II*, 515 F.Supp. at 452-455. Under the heading "FINDINGS OF FACT," the following appears:

1. The court again finds as fact each fact found in this Opinion as set forth in the foregoing.

2. As a game trademark, MONOPOLY primarily denotes its producer, Parker Brothers, and primarily denoted its producer when registered.

Id. at 455. We consider finding 2 to be one of ultimate fact, and subject to the "clearly erroneous" standard of Rule 52(a). See *Pullman-Standard*, *supra*, ____ U.S. at ____, 102 S.Ct. at 1789.

The district court also said " 'Primary significance' logically implies a hierarchical priority over a competing alternative." 515 F.Supp. at 454. Dictionary definitions are in accord. Funk & Wagnalls' New Standard Dictionary gives "primary 1. First in . . . thought or intention, 2. First in degree, rank or importance, most fundamental, chief. . . ." Webster's New International Dictionary (2d Ed.) gives "1. First in . . . intention; 2. First in . . . importance; chief, principal. . . ." We are not sure what the district court meant by a "competing alternative." To us, this carries some suggestion of "either, or." Yet it is nearly always the case, as the district court recognized, that a trademark will identify both the product and its producer. *Anti-Monopoly II*, 515 F.Supp. at 454. Indeed, its value lies in its identification of the product with its producer.

In its opinion, the district court supports its finding 2 as follows:

The difficulty in this regard arises due to the public's dual usage of the tradename, denoting both product and source. For example, the mark "Ford" to the average consumer denotes *both* car and motor car company. However, to demonstrate "primary significance" it is necessary to show more than a high percentage of the consum-

ing public who recognize MONOPOLY as a brand name (as defendant has done: 63% of those polled recognized MONOPOLY as a "brand name"). It is necessary to show more than a public awareness that Parker Brothers is the sole manufacturer of MONOPOLY (55% correctly identified Parker Brothers in defendant's survey). "Primary significance" logically implies a hierarchical priority over a competing alternative.

Yet the cumulative weight of the evidence does satisfy this court that the primary significance of MONOPOLY in the public's eye is to denote a "Parker Brothers' Game" (i.e., source) in contradistinction to that "popular game of MONOPOLY" (product). Parker Brothers has expended substantial time, energy, and money in promoting and policing their trademark, expending over \$4 million in advertising expenditures. One result of these diligent efforts has been the extraordinary success Parker Brothers has achieved in creating public source awareness. Over 55% of the American public correctly identified Parker Brothers as the producer of the game. Cf. *Selchow & Righter Co. v. Western Printing & Lithographing Co.*, D.C., 47 F.Supp. 322, 326 (court finding it "very evident that any ordinary customer, going into a store, and asking for the game "PARCHEESI" had no information as to who might have manufactured and produced the game.") An even more impressive display of the amount of goodwill which Parker Brothers has imbued through its various games—especially MONOPOLY—is the finding of plaintiffs survey that one out of three MONOPOLY purchasers do so primarily because "they like Parker Brothers' products." Hence, source attribution is a dominant perceived effect of the MONOPOLY trademark. This court cannot say from the facts before it that it is not the "primary significance" of the mark.

Id. at 454-455 (emphasis in the original).

In considering whether these findings, and finding 2, are clearly erroneous, we have in mind an obvious proposition. The word "Monopoly," while not in its ordinary meaning descriptive of the game "Monopoly," is an ordinary English word, and it does describe the objective of the game. This was recognized

in the rules of the game published by Parker Brothers in 1935. They begin with:

BRIEF IDEA OF THE GAME

THE IDEA OF THE GAME is to BUY and RENT or SELL properties so profitably that one becomes the wealthiest player and eventual MONOPOLIST.

A Monopolist has a monopoly. By choosing the word as a trademark, Parker Brothers subjected itself to a considerable risk that the word would become so identified with the game as to be "generic."

In *Anti-Monopoly II* the district court also said this: "Unless the Ninth Circuit standard is meant to foreclose the possibility of trademark protection for any producer of a unique game whose corporate name does not appear in the title of the game (e.g., 'SCRABBLE,' 'TOWER OF BABBLE'), then its test cannot be used here to thwart MONOPOLY's trademark rights." 515 F.Supp. at 455. Nothing in our opinion in *Anti-Monopoly I* even hints at the relevance of whether or not the corporate name of the producer of a game appears in the title of the game, and our opinion does not foreclose the possibility of trademark protection of the name of a game that does not embody the corporate name of its producer. But our opinion does squarely hold as follows: "Even if only one producer—Parker Brothers—has ever made the MONOPOLY game, so that the public necessarily associates the product with that particular producer, the trademark is invalid unless source identification is its primary significance." 611 F.2d at 302.

The district court obviously felt that our opinion in *Anti-Monopoly I* gave Anti-Monopoly an easier task in trying to show that "Monopoly" has become generic than the district court would give. Nevertheless, both we and the district court are bound by our decision in *Anti-Monopoly I*.

We now consider whether finding 2 of the district court is clearly erroneous. We conclude that it is.

As we have seen, the district court relied in part upon the fact that General Mills and its predecessor have spent time, energy, and money in promoting and policing use of the term "Monopoly." That fact, however, is not of itself sufficient to create legally protectable rights. *HMH Publishing Co. v. Brincat*, 9 Cir., 1974, 504 F.2d 713, 719. It is not, of itself, enough that over 55% of the public has come to associate the product, and as a consequence the name by which the product is generally known, with Parker Brothers. *Anti-Monopoly I*, 611 F.2d at 302. See also *Kellogg Co. v. National Biscuit Co.*, 1938, 305 U.S. 111, 118, 59 S.Ct. 109, 113, 83 L.Ed. 73 (the "Shredded Wheat" case). Even if one third of the members of the public who purchased the game did so because they liked Parker Brothers' products, that fact does not show that "Monopoly" is primarily source indicating. The very survey on which the district court placed emphasis by italicizing its result shows that two thirds of the members of the public who purchased the game wanted "Monopoly" and did not care who made it.

The real question is what did Parker Brothers and General Mills get for their money and efforts? To us, the evidence overwhelmingly shows that they very successfully promoted the game of Monopoly, but that in doing it they so successfully promoted "Monopoly" as "the name of the game," that it became generic in the sense in which we use that term in trademark law. We recognize that "there is evidence to support" the trial court's findings, *United States Gypsum Co.*, *supra*, 333 U.S. at 395, 68 S.Ct. at 542, but "on the entire evidence [we are] left with the definite and firm conviction that a mistake has been committed." *Id.*

The principal evidence in the case was in the form of consumer surveys, and to these we now turn.

A. The Brand-name Survey.

General Mills conducted a survey based upon a survey approved by a district court in the "Teflon" case, *E.I. Du Pont de Nemours & Co., v. Yoshida International, Inc.*, E.D.N.Y.,

1975, 393 F.Supp. 502. In the survey conducted by General Mills, people were asked whether "Monopoly" is a "brand-name," and were told: "By *brand* name, I mean a name like *Chevrolet*, which is made by *one* company; by common name, I mean 'automobile,' which is made by a number of different companies." (Emphasis in the original.) The results of this survey had no relevance to the question in this case. Under the survey definition, "Monopoly" would have to be a "brand name" because it is made by only one company. This tells us nothing at all about the *primary* meaning of "Monopoly" in the minds of consumers.

It is true that the witness through whom the survey was introduced testified on direct examination that as a result of it his opinion was that "Monopoly" primarily denotes source or producer. However, on cross-examination and redirect examination it became clear that this witness had done no more than reduplicate the "Teflon" survey (with appropriate substitutions and slight additions) and had no opinion on the relevance of this survey to any issue in the present case. The brand-name survey is not even some evidence to support finding 2; it is no evidence to support it.

B. The "Thermos" Survey.

Anti-Monopoly's first survey was based upon that used in the "Thermos" case, *King-Seeley Thermos Co. v. Alladin Industries, Inc.*, D.Conn., 1962, 207 F.Supp. 9, 20-21, *aff'd*, 2 Cir., 1963, 321 F.2d 577. In Anti-Monopoly's survey people were asked the question: "Are you familiar with business board games of the kind in which players buy, sell, mortgage and trade city streets, utilities and railroads, build houses, collect rents and win by bankrupting all other players, or not"? About 53% said they were. Those people were then asked: "If you were going to buy this kind of game, what would you ask for, that is, what would you tell the sales clerk you wanted"? About 80% said: "Monopoly."

The witness through whom this survey was introduced testified that Anti-Monopoly gave his firm the questions used in the

"Thermos" survey and asked it to conduct a similar one. Anti-Monopoly provided the wording of the questions in the present survey as well. The research firm was responsible for deciding how to reach a sample that would adequately represent the population of the United States. The witness gave no testimony as to the relevance of the results of the survey to the issues in the case.

In one of its briefs, General Mills points out that the survey used in the "Thermos" case was described as "generally corroborative of the court's conclusions drawn from other evidence," and that the district court which decided the "Teflon" case found a "Thermos"-like survey defective because "the design of the questions more often than not [focused] on supplying the inquirer a 'name,' without regard to whether the principal significance of the name supplied was 'its indication of the nature or class of an article, rather than an indication of its origin,' *King-Seeley Thermos Co.*, *supra*, 321 F.2d at 580." *E. I. Du Pont de Nemours & Co.*, *supra*, 393 F.Supp. at 527. Be that as it may, we think that the results of this survey are compelling evidence of a proposition that is also dictated by common sense: an overwhelming proportion of those who are familiar with the game would ask for it by the name "Monopoly."

C. The Motivation Survey.

After the remand to the district court, Anti-Monopoly commissioned a further survey. This survey was based upon the following language from our opinion in *Anti-Monopoly I*:

It may be that when a customer enters a game store and asks for MONOPOLY, he means: "I would like Parker Brothers' version of a real estate trading game, because I like Parker Brothers' products. Thus, I am not interested in board games made by Anti-Monopoly, or anyone other than Parker Brothers." On the other hand, the consumer may mean: "I want a 'Monopoly' game. Don't bother showing me Anti-Monopoly, or EASY MONEY, or backgam-

mon. I am interested in playing the game of Monopoly. I don't much care who makes it."

In the first example, the consumer differentiates between MONOPOLY and other games according to source-particular criteria. In the second example, source is not a consideration. The relevant genus, or product category, varies accordingly. At the urging of Parker Brothers, the district court erred by first defining the genus, and then asking the "primary significance" question about the wrong genus-species dichotomy. The proper mode of analysis is to decide but one question: whether the primary significance of a term is to denote product, or source. In making this determination, the correct genus-species distinction, that is, the correct genericness finding, follows automatically.

611 F.2d at 305-306. The wording of the questions was provided by Dr. Anspach, Anti-Monopoly's president, and by the expert who testified at trial. The expert had studied our first opinion. The survey was designed to ascertain the use of the term "Monopoly" by those who had purchased the game in the past or intended to do so in the near future. It was conducted by telephone. The results were as follows: 92% were aware of "Monopoly," the business board game produced by Parker Brothers. Of that 92%, 62% either had "purchased 'Monopoly' within the last couple of years" or intended to purchase it in the near future. Those people were asked why they had bought or would buy monopoly. The answers exhibited the following pattern: 82% mentioned some aspect of the playing of the game (e.g., that they played it as a kid, it was a family game, it was enjoyable, it was fun to play, it was interesting), 14% mentioned some educational aspect of the game, 7% mentioned the equipment (e.g., saying it was durable) or said they were replacing a set, 1% spoke of price, 34% gave other reasons neutral to the issues in this case (e.g., it was for a gift, the game was a classic, people like the game). The percentages total more than 100 because respondents often gave more than one reason.

The people who said that they had purchased the game within the last couple of years or would purchase it in the near

future were then given a choice of two statements and were asked which best expressed their reasons. Sixty-five percent chose: "I want a 'Monopoly' game primarily because I am interested in playing 'Monopoly,' I don't much care who makes it." Thirty-two percent chose: "I would like Parker Brothers' 'Monopoly' game primarily because I like Parker Brothers' products."

A very similar "intercept survey" was conducted by face to face interviews. The results were very close to those of the telephone survey, but the expert did not claim that the intercept study was validly projectable.

The district court indicated its reasons for rejecting this survey. Insofar as these are findings of fact they must be accorded the deference required by Rule 52(a), and, giving them that deference, we hold them to be clearly erroneous. The district court's major objection to the survey was that it sought an explanation of an actual purchaser's motivation in purchasing the game rather than the primary significance of the word. *Anti-Monopoly, Inc.*, 515 F.Supp. at 453. This objection cannot stand. In our earlier opinion we made it clear that what was relevant was the sense in which a purchaser used the word "Monopoly" when asking for the game by that name. The survey was a reasonable effort to find that out and was modelled closely on what we said in our opinion.

The district court thought that the survey was invalidated by the fact that in the first question people were asked if they were "aware of 'Monopoly,' the business board game *produced* by *Parker Brothers*" (emphasis supplied). It supposed that the presence of the emphasized words somehow inhibited those who might otherwise have responded to later questions that they bought the game because it was produced by Parker Brothers. No evidence or expert opinion was given to support this view and it has no inherent plausibility.

In a footnote the district court said of this survey that "other methodological deficiencies abound." *Id.*, 515 F.Supp. at 453 n.4. One suggested deficiency is that Professor Anspach sug-

gested the language that was used. This is taken to be evidence of "inherent bias." General Mills argues to us that little weight should be given to this survey because it was devised by Dr. Anspach and the survey firm without the mediation of a trademark attorney. We find no merit in these objections.

The district court found that the study was "overwhelmingly prone to errors of subjective grading." *Id.* No doubt it was referring to the process by which responses were categorized as, for example, education, enjoyable, "played it as a kid," or equipment. This process of categorization was not purely mechanical, and did involve some use of human judgment. However, we are not prepared to dismiss every process that includes the operation of human judgment as "overwhelmingly prone to errors of subjective grading." Nor do we find any special reasons to suspect the exercise of judgment in the case of this survey. The categories that were listed strike us as reasonable ones.

Neither the district court nor General Mills claims that there were *in fact* errors of judgment, but only that there might have been. The raw responses to the survey were at one point offered in evidence by Anti-Monopoly, but the offer was withdrawn after General Mills objected, citing F.R. Evidence 705, 1005 and 1006, and the district judge said: "if [counsel for General Mills had] asked for them, he could have received them. If he received them, he could have turned them over to his expert to check them out and see if they give a reliable or non-reliable basis for the opinion. But since he didn't ask for them, I don't think they should go into evidence." Under these circumstances, General Mills cannot now argue that the raw responses were not in fact correctly categorized.

Finally, in the same footnote, the district court suggested that the result that 82% of monopoly purchasers buy for "product related" reasons *cannot be reconciled* with the other result that 32% of actual or potential buyers chose the statement "I would buy Parker Brothers' 'monopoly' game primarily because I like Parker Brothers' products." This is a misconcep-

tion of the survey results. The comparable figure to the 32% is the 65% who chose the statement "I want a 'monopoly' game primarily because I am interested in playing 'monopoly,' I don't much care who makes it." The 82% who gave "product related" answers no doubt had both product related and source related reasons for buying, and, with some, enough to reduce 82% to 65%, the source related reason was stronger when the person had to choose. But it is still true that 65% chose product, rather than source.

We conclude that the findings regarding the survey are clearly erroneous, and that it does support the conclusion that the primary significance of "Monopoly" is product rather than source.

D. The Tide Survey.

General Mills introduced a survey that was intended as a *reductio ad absurdum* of the motivation survey. It showed that when asked to supply a reason for buying Tide about 60% of those who might buy it now or in the future said that they would buy Tide because it does a good job. However, when asked "Would you buy Tide primarily because you like Procter and Gamble's products, or primarily because you like Tide detergent?" about 68% indicated the latter reason. There were various respects in which this survey was different from the motivation survey used by Anti-Monopoly, but we shall not suddenly attach great importance to technical considerations. We suspect that these results tend to show that the general public regards "Tide" as the name of a particular detergent, having particular qualities, rather than as one producer's brand name for the same detergent which is available from a variety of sources. We do not know whether the general public thinks this, or if it does, is correct in thinking this, or whether Procter and Gamble intend them to think it. If the general public does think this, and if the test formulated in *Anti-Monopoly I* could be mechanically extended to the very different subject of detergents, then Procter and Gamble might have cause for alarm. The issue is not before us today. The motiva-

tion survey conducted by Anti-Monopoly, Inc. was in accordance with the views we expressed in *Anti-Monopoly I*. The results in the *Tide* Survey are of no relevance to this case.

E. Conclusion.

We hold that Finding 2 is clearly erroneous because, although there is some evidence to support it, our examination of the evidence leaves us with the definite and firm conviction that a mistake has been committed. We hold that, as applied to a board game, the word "Monopoly" has become "generic," and the registration of it as a trademark is no longer valid.

VII. Other Issues.

The district court must determine whether Anti-Monopoly is taking reasonable care to inform the public of the source of its product, and if it finds that this is not so may enjoin the sale of anti-monopoly save upon appropriate conditions. *Anti-Monopoly I*, 611 F.2d at 307.

We remand the case. The district court shall enter judgment for Anti-Monopoly, Inc. on the question of trademark validity and take whatever actions are necessary and consistent with this opinion.

APPENDIX B

ANTI-MONOPOLY, INC.,
a California Corporation, Plaintiff,

v.

GENERAL MILLS FUN GROUP, INC.,
a Nevada Corporation, Defendant-Counterclaimant.

No. C-74-0529 SW.

United States District Court,
N. D. California.

May 11, 1981.

Plaintiff, a corporation engaged in the business of selling a board game called "Antimonopoly," brought action to challenge validity and enforceability of defendant's "Monopoly" trademark. Judgment declaring the "Monopoly" mark valid and enforceable was reversed, 611 F.2d 296, and case was remanded for redetermination of trademark validity issue. On remand, the District Court, Spencer Williams, J., held that: (1) absent evidence that the primary significance of "Monopoly" in the public's eye was to denote a product in contradistinction to the producer, the "Monopoly" trademark was not invalid so as to require its cancellation either because the word "Monopoly" was at the time of its registration, or had since become, the generic or common descriptive name of article or a game, and (2) the use of the name "Antimonopoly" as the title of plaintiff's game and otherwise in connection with that game created a strong likelihood of confusion in the public mind and was such as to constitute an infringement of the defendant's "Monopoly" trademark.

Judgment for the defendant.

Robert S. Daggett, Brobeck, Phleger & Harrison, San Francisco, Cal., Oliver P. Howes, Jr., Nims, Howes, Collison & Isner, New York City, for defendant and counterclaimant General Mills Fun Group, Inc.

Carl E. Person, New York City, John H. Denton, Oakland, Cal., for plaintiff.

OPINION AND ORDER ON REMAND

SPENCER WILLIAMS, District Judge.

Plaintiff Anti-Monopoly, Inc., a California corporation which has engaged in the business of selling a board game it calls ANTI-MONOPOLY, brought this action challenging the validity and enforceability of defendant's MONOPOLY game trademark. After a trial before this court, a judgment was granted declaring the MONOPOLY trademark valid and enforceable, and that Anti-Monopoly's use of the name ANTI-MONOPOLY constituted an infringement thereof. On appeal to the Ninth Circuit Court of Appeals, the appellate court reversed and remanded to this court for a redetermination of the trademark validity issue. *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296 (9th Cir. 1979). In so doing, the Court of Appeals invited this court to entertain new evidence bearing on the validity issue, specifically the consuming public's perception and usage of the term "MONOPOLY."

Accordingly, the court received and considered proposals on both sides regarding the scope and content of further post-remand proceedings. On July 11 and July 18, 1980, the court conducted further evidentiary hearings. At the hearing the court received documentary evidence and the testimony of four witnesses. The court received and considered written arguments of counsel on the law and facts and, after the hearing closed and on July 22, 1980, the court heard and considered further oral argument of counsel. Having carefully considered the oral and documentary evidence received both at the trial and at the hearings after remand, and the oral and written arguments of counsel, and having observed the demeanor of the witnesses, the court now finds the following:

I

FACTUAL BACKGROUND

According to its creator, Ralph Anspach, a professor of economics, the primary focus of ANTI-MONOPOLY is to emphasize and support the values of the competitive private enterprise system. The game was first created in 1971, Anspach attempting unsuccessfully to market it under the name "BUST THE TRUST." Professor Anspach decided the problem lay in the name, which he changed to ANTI-MONOPOLY, thus achieving a notable market success. The game, as packaged, bears remarkable similarities to MONOPOLY in terms of box size, lettering, board configuration and design. Since the game was first sold in December 1973, plaintiff has sold approximately 419,000 games, taking in close to one million dollars.

Defendant and counterclaimant General Mills Fun Group, Inc. is a Nevada corporation engaged in business in California and elsewhere throughout the world with its principal place of business in Minnesota. Parker Brothers is an unincorporated division of defendant engaged in the business, among others, of manufacturing and selling games. Parker Brothers is the owner of the registered trademark MONOPOLY, No. 326,723 which was registered with the United States Patent and Trademark Office on July 30, 1935 and No. 338,834 registered on September 15, 1936. Parker Brothers' patent for MONOPOLY, issued December 31, 1935, expired in 1952.

For over forty-five years, Parker Brothers has been the sole producer of the real estate trading game known to the public as MONOPOLY. Since 1935, Parker Brothers and its predecessor have sold 80 million sets of the MONOPOLY game in the United States for \$125 million. In the past ten years it has sold 24 million sets, and since 1973 its sales have approximated 80,000 sets annually. Parker Brothers has diligently and consistently promoted and policed its MONOPOLY mark, expending \$4 million in publicizing the trademark since its first use, \$2.1 million in publicizing the mark in the last ten years,

and \$234,000 in publicizing expense in 1976. Defendant has enjoyed exclusive use of its MONOPOLY trademark for all of this period, and the mark has not been used by anyone else except plaintiff for board games or otherwise except under licenses and other permission granted by Parker Brothers.

II

Three principal issues are raised on remand. First, and foremost, the question as to the validity of the MONOPOLY trademark has been remanded for redetermination in light of the Ninth Circuit's test explicitly set forth in *Anti-Monopoly*, *supra*, 611 F.2d at 306, to wit: "whether the primary significance of . . . [the term, MONOPOLY] is to denote *product or source*." Second, if the MONOPOLY mark is held valid, does Anti-Monopoly's use thereof constitute an infringement? And third, irrespective of the trademark validity issue, whether Anti-Monopoly's exploitation of similar "competition factors" with the MONOPOLY game produced by Parker Brothers constitutes unfair competition under state law.

III

A. Validity Of Monopoly Trademark

The thrust of plaintiff's argument is that the MONOPOLY trademark is invalid and should be cancelled either because (1) MONOPOLY was at the time of its registration, or has since become, the generic or common descriptive name of an article, or in this case, a game, or (2) the trademark was acquired through fraudulent means. Under 15 U.S.C. § 1064(c) a trademark may be cancelled if it becomes the common descriptive name of an article or substance or was was obtained fraudulently. Unless one of these or certain other specified grounds exist, the right to use a trademark which has been in continuous use for five consecutive years after registration becomes incontestable and is conclusive evidence of the registrant's sole right to use the mark in commerce. 15 U.S.C. §§ 1065 and 1115(b).

After the initial trial, this court found against plaintiff on the fraud allegation, and plaintiff has not raised that issue on appeal. The remaining issue involves the question of "genericness" of the MONOPOLY mark.

1. *Genericness At Time Of Registration.*

Plaintiff attempted to show at trial that at the time of Parker Brothers' trademark registration, MONOPOLY was already a widely played game known by that name. The evidence introduced to support this contention consists chiefly of isolated and sporadic examples of individuals playing old oilcloth games referred to in some instances as "Monopoly," the "Landlord's Game," or some other variation thereof. The Ninth Circuit found it "significant . . . that the original patent application in August, 1935 divulged that 'the game is known on the market as Monopoly.' This usage, of course, predated any association of Parker Brothers with the game." 611 F.2d at 306, n.7.

This court finds the evidence to the contrary. Parker Brothers' MONOPOLY had been registered by trademark in July of 1935, one month before the patent application was filed. At the date of the patent application reference, thus, Parker Brothers had a clear association with MONOPOLY. Moreover, it must be recalled that MONOPOLY's inventor, Mr. Clarence Darrow, assigned his rights in the game to Parker Brothers in March, 1935.

In order to be "generic," the name MONOPOLY, in the minds of the consuming public, must primarily denote product rather than source. It remains unclear how widely played the precursors to modern MONOPOLY were in the 1920s and early '30s. Plaintiff has simply made no showing as to what the public's conception of the term was at that juncture or indeed how widely played it actually was. As Clarence Darrow, and later his successor, Parker Brothers, popularized a specific game they called MONOPOLY, this court cannot find that the trademark when registered denoted "a game" rather than the "game's producer." Because Anti-Monopoly has the burden of

showing genericness by convincing evidence, *Feathercombs, Inc. v. Solo Products Corporation*, 306 F.2d 251 (2d Cir. 1962), this finding must be for defendant.

2. Genericness Since Registration.

The primary issue before this court on remand relates to plaintiff's assertion that the MONOPOLY mark became generic in contemporary usage over time, so that current usage of the term "MONOPOLY" by consumers refers to the game and not the producer. In *Anti-Monopoly*, the Ninth Circuit determined that this court had employed the wrong test in determining genericness (by first defining the "genus" as "all board games involving real estate trading"). 611 F.2d at 305. As a result, this court "thus obscured the basic issue: whether MONOPOLY primarily describes a product, or a producer." *Id.*

This error transpired, the Ninth Circuit observed, because this court had "lumped together in the species category" the two alternatives between which the proper test was designed to discern: attribution to either *product or producer*. *Id.* Only if a trademark's "primary significance" is to denote the *source or producer*, as opposed to denoting the product itself, can the trademark be sustained. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118, 59 S.Ct. 109, 113, 83 L.Ed. 73 (1938); *Anti-Monopoly, supra*, 611 F.2d at 306. As Judge Learned Hand made clear in *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921), the test relates to the average consumer's comprehension of the mark: "What do the buyers understand by the word for whose use the parties are contending?"

In a normal context this test is implemented by ascertaining whether a mark denotes a "particular producer's goods or services . . . [or whether] the word is identified with all such goods or services, regardless of their suppliers." *Surgicenters of America v. Medical Dental Surgeries*, 601 F.2d 1011, 1016 (9th Cir. 1979). This is a straightforward task in markets

where several producers manufacture the generic item in question. In this case, the analysis is complicated by the fact that Parker Brothers has been, and remains, the only producer to manufacture MONOPOLY since it acquired the rights to do so from MONOPOLY's creator, Mr. Clarence Darrow, in 1935.¹ The Ninth Circuit recognized this, explicitly applying its test in the one producer situation, so that even where "the public necessarily associates the product with that particular producer, the trademark is invalid *unless* source identification is its primary significance." 611 F.2d at 302.

However succinctly stated, the Ninth Circuit standard, unless it is intended to effectively foreclose trademark protection for any single producer of a unique game—*e.g.*, SCRABBLE²

¹ This case is sharply contrasted with both *Selchow & Righter Co. v. Western Printing & Lithographing Co.*, 47 F. Supp. 322, 326 (E.D. Wis. 1942), *aff'd*, 142 F.2d 707, 709 (7th Cir.), *cert. denied*, 323 U.S. 735, 65 S.Ct. 75, 89 L.Ed 589 (1944), and *Golomb v. Wadsworth*, 592 F.2d 1184, 201 U.S.P.Q. 200, 201 (1979). In *Selchow* the court found that other manufacturers were indeed also producing PARCHEESI (but under a different name), and that the origins of the game could be traced back centuries as a royal game of India. 142 F.2d at 708. Thus, the parallels to chess, checkers, backgammon and other venerated international games of unknown origin are far closer than here. MONOPOLY, this court has found, was "created" by Mr. Clarence Darrow and acquired by Parker Brothers.

Similarly, in *Golomb*, the Court of Customs and Patent Appeals noted that the asserted trademarks, "POLYOMINOES" and "PENTOMINOES," had actually received public currency before the registrant had created his game titles ("POLYMINOES" reported to be widely popular three years before registrant claimed he brought them to the attention of the public.) 592 F.2d at 1186. This court has rejected a similar finding here.

² In *Selchow & Righter Co. v. McGraw-Hill Book Co.*, 580 F.2d 25 (2d Cir. 1978), a preliminary injunction was granted against a possible infringement of the trademark SCRABBLE, a game solely produced by Selchow & Righter. The court held that the genericness question of SCRABBLE "is fairly open to proof." 580 F.2d at 28.

or TOWER OF BABBLE³—which this court believes it is not, it must be applied to the facts with some degree of care. In the case of the single producer of a unique item, it is a difficult and delicate task to separate product from source characteristics as they appear in the consumer's mind.

The parties presented additional survey evidence to this court which purport to make this fine distinction. The Anti-Monopoly survey, which was supposedly based on a specific guiding language in the Ninth Circuit's opinion, misconstrued the nature of the inquiry mandated by the Ninth Circuit in addition to manifesting a number of serious methodological flaws. The test set forth in that opinion requires a determination of the "primary significance" of the mark "MONOPOLY" in the average consumer's mind. It *does not* seek an explanation of an actual purchaser's motivation for purchasing the game. The two are not the same.

The Anti-Monopoly survey was restricted to persons who had purchased MONOPOLY within the past few years or who intended to purchase MONOPOLY in the near future. The survey asked three questions: (1) "Are you aware of 'MONOPOLY,' the business board game produced by Parker Brothers?", (2) "Have you purchased MONOPOLY within the last couple of years?", or "Is it possible that you would buy 'MONOPOLY' now or in the near future either for yourself, as a replacement, or as a gift?", and (3) in the case of those who said they bought MONOPOLY within the last couple of years, "Why did you buy 'MONOPOLY'?", and in the case of persons stating the possibility of future purchase in the words of the question put, "Why would you buy 'MONOPOLY'?"

³ In *Dawn v. Sterling Drug Co.*, 319 F. Supp. 358 (C.D. Cal. 1970), the court granted trademark protection (injunction) for the unique game title TOWER OF BABBLE against its use as a slogan for Bayer Aspirin.

Defendants contend that by its design, plaintiff's study avoids the very issue of this inquiry:

The Anti-Monopoly survey states *in the first question* that MONOPOLY is a "business board game produced by Parker Brothers." The appellate opinion directs this Court to find whether or not MONOPOLY has a primary source identification. The Anti-Monopoly survey was not designed to gather source-related data but, instead, to assemble a mass of mixed, heterogeneous data from which to argue to this Court that the public purchases MONOPOLY for reasons primarily unrelated to source. The design accomplishes this, as we have seen, by including Parker Brothers as the name of the producer of MONOPOLY in the first question, and in this way *brushes aside as an assumed fact, the very fact on which the Ninth Circuit has mandated further inquiry.* [Emphasis added]

The court is in complete accord with this assessment of plaintiff's study.⁴ Nevertheless, when given a specific choice between source and product attribution, plaintiff's own study finds that one in three consumers purchased (or would purchase) "MONOPOLY primarily because they like Parker Brothers' products."⁵ Of course, while it is significant that such

⁴ Other methodological deficiencies abound. The court finds that the design of the study was inherently biased towards a favorable outcome for Anti-Monopoly, including intimations that Prof. Anspach suggested the language which was used. Secondly, the scale which deduced the statistic that 82% of the MONOPOLY purchasers buy for "product related" reasons is: (1) overwhelmingly prone to errors of subjective grading, and (b) cannot be reconciled with the alternate finding that one of three buyers do so out of affection for Parker Brothers' products. The court rejects plaintiff's study.

⁵ Following the "open-end" questions, respondents were asked a structured question: "Which of these two statements best expresses your meaning when you ask [to purchase] . . . MONOPOLY in a store?" Choices: "(1) I would like Parker Brothers' 'MONOPOLY' game primarily because I like Parker Brothers' products." or "(2) I

a large percentage of MONOPOLY users purchased their games because of their affection for Parker Brothers' products, ascertaining the *motive* for a consumer's purchase is not the determination envisioned by the Ninth Circuit test. One fact which this court need not ignore is that most consumers, indeed an overwhelming proportion thereof, purchase any given product not out of goodwill or affection for the producer, but because they want or favor the product. Only a shareholder of the General Mills Fun Group (Parker Brothers' parent) could reasonably be expected to purchase a Parker Brothers' game out of an affection or goodwill for the corporation. Moreover, the "primary significance" of a trademark corresponds more to the recognition of a mark as the brand name of a particular producer than it does to a reason for purchasing. Consumers purchase games because they wish to play the games they seek, yet this fact alone should not serve to invalidate an otherwise legitimate trademark. The makers of MONOPOLY should not be penalized simply because they

want 'MONOPOLY' game primarily because I am interested in playing 'MONOPOLY.' I don't much care who makes it."

These responses were pulled, verbatim, from an illustration in the text of the appellate court opinion. 611 F.2d at 305-306. Plaintiffs expert, not a trained attorney, misconstrued the purpose of the illustration, which was to illustrate a point, *not* to suggest language for a scientific study.

This weakness of plaintiff's study becomes most convincing when one considers defendant's TIDE survey. The TIDE survey showed that when TIDE is surveyed on a substantially identical design, 67.7% of its purchasers report that they buy (or would buy) TIDE because they simply like TIDE, 6.7% buy (or would buy) TIDE for some other reason, 4.8% don't know, and only 12.8% report that they buy (or would buy) TIDE because of their affection for Proctor & Gamble products. Yet it seems beyond argument that TIDE is a valid trademark. But if TIDE were the *only detergent* available, would this mean that TIDE could not protect its trade name?

have created a unique product which they have actively and diligently promoted.

The dispositive issue hence is *not* why consumers buy MONOPOLY sets, but rather, what is their *understanding* of the name MONOPOLY? Does it primarily denote *product* or *producer*? In a single producer case (there is no other producer of MONOPOLY) it will not suffice to analyze source-related as opposed to source-irrelevant characteristics because most source related characteristics (*e.g.*, price, style, durability, quality, etc.) are purely relative terms, implying a comparison with product substitutes, or near substitutes. Here there are no substitutes; there is only MONOPOLY. Accordingly, the Ninth Circuit's mandate that this court divine the "primary significance" of that term in the consumer's mind must necessarily involve subtle inferences into the complex, convoluted mind of the American consumer—an unenviable task.

The difficulty in this regard arises due to the public's dual usage of the tradename, denoting both product and source. For example, the mark "Ford" to the average consumer denotes *both* car and motor car company. However, to demonstrate "primary significance" it is necessary to show more than a high percentage of the consuming public who recognize MONOPOLY as a brand name (as defendant has done: 63% of those polled recognized MONOPOLY as a "brand name"). It is necessary to show more than a public awareness that Parker Brothers is the sole manufacturer of MONOPOLY (55% correctly identified Parker Brothers in defendant's survey). "Primary significance" logically implies a hierarchical priority over a competing alternative.

Yet the cumulative weight of the evidence does satisfy this court that the primary significance of MONOPOLY in the public's eye is to denote a "Parker Brothers' Game" (*i.e.*, source) in contradistinction to that "popular game of MONOPOLY" (product). Parker Brothers has expended substantial time, energy, and money in promoting and policing their trademark, expending over \$4 million in advertising ex-

penditures. One result of these diligent efforts has been the extraordinary success Parkers Brothers has achieved in creating public source awareness. Over 55% of the American public correctly identified Parker Brothers as the producer of the game. *Cf. Selchow & Righter Co. v. Western Printing & Lithographing Co.*, D.C., 47 F.Supp. 322, 326 (court finding it "very evident that any ordinary customer, going into a store, and asking for the game "PARCHESSI" has no information as to who might have manufactured and produced the game.") An even more impressive display of the amount of goodwill which Parker Brothers has imbued throughout its various games—especially MONOPOLY—is *the finding of plaintiff's survey that one out of three MONOPOLY purchasers do so primarily because "they like Parker Brothers' products."* Hence, source attribution is a dominant perceived effect of the MONOPOLY trademark. This court cannot say from the facts before it that it is not the "primary significance" of the mark. Unless the Ninth Circuit standard is meant to foreclose the possibility of trademark protection for any producer of a unique game whose corporate name does not appear in the title of the game (*e.g.*, "SCRABBLE," "TOWER OF BABBLE"), then its test cannot be used here to thwart MONOPOLY's trademark rights.

IV

FINDINGS OF FACT

1. The court again finds as fact each fact found in this Opinion as set forth in the foregoing.

2. As a game trademark, MONOPOLY primarily denotes its producer, Parker Brothers, and primarily denoted its producer when registered.

3. The parties have offered no further evidence on the issue of trademark infringement. After further considering the matter in light of the preceding finding of fact, the court again finds that use of the name *ANTI-MONOPOLY* as the title of plaintiff's game and otherwise in connection with that game

has created and creates a strong likelihood of confusion in the public mind.

4. The parties also have offered no further evidence on Parker Brothers' state law claims of unfair competition and trademark dilution or plaintiff's defense of unclean hands. After further considering all of the evidence in the light of Finding 2 above, the court again finds, for purposes of the state law claims, that there is a strong likelihood that the public will be deceived as to the source of the ANTI-MONOPOLY game due to confusion with the mark MONOPOLY; that plaintiff's name therefore dilutes Parker Brothers' trademark MONOPOLY; and that Parker Brothers has neither abused the MONOPOLY trademark nor committed any fraud in the acquisition of the original trademark.

5. The court further finds as fact anything set out below in its conclusions of law which is finding of fact or a mixed finding of fact and conclusion of law.

On the foregoing further Findings of Fact, the court now makes and enters the following:

V

CONCLUSIONS OF LAW

1. The court incorporates by this reference each Conclusion of Law contained in its Opinion and Order filed and entered April 4, 1977, except that the court has reconsidered in the light of the opinion of the Court of Appeals plaintiff's claim that the MONOPOLY trademark was generic when registered or has become so, 15 U.S.C. §§ 1065(4) and 1115(b)(2), as against the claim of defendant and counter-claimant that its right to exclusive use of the MONOPOLY mark is incontestable by reason of the same statutory provisions. After such reconsideration, which has included the matters embraced in Finding 2 above, the court again concludes that the MONOPOLY trademark is in all respects valid and enforceable and that use by plaintiff of the title ANTI-

MONOPOLY for its game infringes the **MONOPOLY** trademark.

2. The court further concludes as law anything found as fact in the foregoing Findings of Fact which is either a conclusion of law or a mixed conclusion of law and finding of fact.

The court has this day entered its final judgment in conformity herewith.

APPENDIX C

ANTI-MONOPOLY, INC.,
Plaintiff-Appellant,

v.

GENERAL MILLS FUN GROUP, *et. al.*,
Defendant-Appellees.

No. 77-2302.

United States Court of Appeals,
Ninth Circuit.

Dec. 20, 1979.

Manufacturer of the game ANTI-MONOPOLY brought suit challenging the validity and enforceability of defendant's MONOPOLY game trademark. The United States District Court for the Northern District of California, Spencer Williams, J., rendered judgment for defendant, and plaintiff appealed. The Court of Appeals, Wallace, Circuit Judge, held that the district court erred in focusing on whether the primary significance of MONOPOLY is to denote "all board games involving real estate trading" or instead a "particular and very popular board game produced by a single company"; accordingly, the case had to be remanded for a determination of whether consumers use the term MONOPOLY primarily to denote the product, or instead to denote its producer.

Reversed and remanded.

Robert B. Chickering (argued) of Warren Chickering & Grunewald, and John H. Denton, Oakland, Cal., for appellant Anti-Monopoly, Inc.

Robert S. Daggett (argued) of Brobeck, Phleger & Harrison, San Francisco, Cal., and Oliver P. Howes of Nims, Howes, Collison & Isner, New York City, for defendants-appellees.

Appeal from the United States District Court for the Northern District of California.

Before WALLACE and SNEED, Circuit Judges and BLUMENFELD,* District Judge.

WALLACE, Circuit Judge:

Anti-Monopoly, Inc. (Anti-Monopoly) appeals from a district court judgment declaring that the MONOPOLY trademark of Parker Brothers, an unincorporated division of General Mills Fund Group, Inc., is valid and enforceable, and that Anti-Monopoly's use of the name "Anti-Monopoly" as the title of its own game constitutes an infringement thereof. Anti-Monopoly also appeals from the district court's issuance of a permanent injunction which, among other things, forbids Anti-Monopoly from using the words ANTI-MONOPOLY as a trademark, or trade or corporate name, and which requires Anti-Monopoly to submit all offending materials for destruction. We reverse and remand the case to the district court for further findings concerning the validity and enforceability of the MONOPOLY trademark.

I

The game of "Monopoly" was first played from 1920 to 1932 on various college campuses by a small group of individuals, many of whom were related by blood or marriage. In late 1932 or early 1933 one of these players introduced Charles Darrow to the game, and gave him a handmade game board, rules and associated equipment. Immediately thereafter Darrow commenced commercially producing and selling "Monopoly" game equipment.

In October 1933, Darrow obtained a copyright on some part of the "Monopoly" game equipment, probably the rules. In March 1935, Parker Brothers acquired all of Darrow's rights to

*Honorable M. Joseph Blumenfeld, United States District Judge, District of Connecticut, sitting by designation.

the "Monopoly" game and game equipment. In August 1935, Darrow applied for a patent. The application stated:

This invention relates to board game apparatus and is intended primarily to provide a game of barter, thus invoking trading and bargaining.

* * * * *

The board as a whole is indicated . . . in Fig. 1. Inasmuch as the game is known upon the market as Monopoly, that game is indicated [in the middle of the board as pictured in fig. 1].

The patent issued on December 31, 1935 and was promptly assigned to Parker Brothers. It expired 17 years later, in 1952.

Parker Brothers registered the word MONOPOLY as a trademark in 1935 and 1936. It remains the owner of trademark registration numbers 326, 723, issued July 30, 1935, and 38,834, issued September 15, 1936, for the MONOPOLY trademark.

During the years 1935 to 1952, Parker Brothers relied primarily on its patents to protect its monopoly of "Monopoly." When the patent expired, however, Parker Brothers began to concentrate on preserving the value of its MONOPOLY trademark. Parker Brothers eliminated references in the game rules to becoming the "monopolist." It also created the "generic" expression "real estate trading game equipment," which it used in conjunction with the MONOPOLY trademark on the game carton and in advertisements. Parker Brothers apparently hoped by these steps to keep the word MONOPOLY from falling into the public domain as a "generic" term. The major question which we reach on appeal is whether Parker Brothers succeeded.

In December 1973, Anti-Monopoly, headed by its president, Ralph Anspach, first marketed "Anti-Monopoly," a game which Anspach created. Anspach asserts that the game is designed to emphasize the values of the competitive private enterprise system. At first he intended to market his game

under the title, "Bust the Trust, The Anti-Monopoly game," but he later decided that "Anti-Monopoly" would be a better title. The United States Patent and Trademark Office rejected Anti-Monopoly's 1973 trademark application because of the possibility of confusion, mistake, or deception. For reasons of its own, Anti-Monopoly chose not to pursue this application any further.

Anti-Monopoly, which has sold over 400,000 of its games, sought a declaratory judgment that the MONOPOLY trademark is invalid and that its use of the name "Anti-Monopoly" does not infringe the MONOPOLY mark. In addition, Anti-Monopoly sought to have the MONOPOLY trademark cancelled. Parker Brothers counterclaimed for the declaratory and injunctive relief which the district court granted, and from which Anti-Monopoly now appeals.

Anti-Monopoly raises four principal contentions in its appeal: (1) That for a variety of reasons, the district court erred when it concluded that the MONOPOLY trademark had not been invalid originally or since become invalid; (2) That the district court erred when it found that Anti-Monopoly had infringed the MONOPOLY trademark; (3) That the district court erred because it did not find that the equitable defense of "unclean hands" barred injunctive relief in favor of Parker Brothers; and (4) That the district court erred when it rejected Anti-Monopoly's demand for a jury trial. We consider each of these contentions in turn.

II

The invalidity issue is not one of easy resolution. Both parties agree that Parker Brothers' MONOPOLY trademark has become incontestable unless: (1) MONOPOLY was, when Parker Brothers first registered the mark, or has since become, the common descriptive name ("generic" name) of the registered article, 15 U.S.C. §§ 1064(c), 1065(4); or (2) Parker Brothers obtained its registration fraudulently, 15 U.S.C. § 1064(c). During final argument in the district court, how-

ever, counsel for Anti-Monopoly conceded that he had failed to prove fraud. Thus, Anti-Monopoly's sole remaining contention regarding the invalidity of the MONOPOLY trademark is that the term Monopoly was originally or has become the generic name for an article.

A. The Genericness Doctrine

The United States encourages invention and development of new products, ideas, and systems by granting, pursuant to the patent laws, limited monopolies over the manufacture and sale of such products. See U.S. Const. art. I, § 8, cl. 8; 35 U.S.C. § 1 *et seq.* But patent protection is a sharply confined exception to a general "principle of free competition in business ideas and intellectual creations." 1 J. McCarthy Trademarks and Unfair Competition, § 1:1 at 2 (1973).¹ Thus, when a patent expires, the idea, system, or product passes into the public domain and may be freely copied, so long as the copyist uses reasonable care to prevent the public from misidentifying his product as that of the original producer. See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 117-19, 59 S.Ct. 109, 83 L.Ed. 73 (1938); *Saxlehner v. Wagner*, 216 U.S. 375, 381, 30 S.Ct. 298, 54 L.Ed. 525 (1910); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185-86, 16 S.Ct. 1002, 41 L.Ed. 118 (1896).

Trademarks, see 15 U.S.C. § 1051 *et seq.*, are not properly used as patent substitutes to further or perpetuate product

¹ The copyright laws are not involved in this case because business ideas, such as a game concept, cannot be copyrighted, see 17 U.S.C. § 102(b); *Baker v. Selden*, 101 U.S. 99, 25 L.Ed. 841 (1880). This copyright rule is analogous to the genericness doctrine of trademark law, however, in that it is designed to prevent extension of product monopolization beyond the 17 years protected by a patent. *Id.* at 102-03.

monopolies. *Smith v. Chanel, Inc.*, 402 F.2d 562, 566-69 (9th Cir. 1968). Rather, trademark policies are designed

(1) to protect consumers from being misled as to the enterprise, or enterprises, from which the goods or services emanate or with which they are associated; (2) to prevent an impairment of the value of the enterprise which owns the trademark; and (3) to achieve these ends in a manner consistent with the objectives of free competition.

HMH Publishing Co. v. Brincat, 504 F.2d 713, 716 (9th Cir. 1974). Buyers may especially trust the constancy of quality emanating from a particular producer. Trademarks enable producers to capitalize on such goodwill, by providing a sure method of identifying a particular producer's goods to the public. Used as a means of identifying the trademark owner's products, a trademark "makes effective competition possible in a complex, impersonal marketplace by providing a means through which the consumer can identify products which please him and reward the producer with continued patronage." *Smith v. Chanel, Inc.*, *supra*, 402 F.2d at 566.

Moreover, once this good will is established, trademarks become an *extremely important medium of advertisement*. Provided that the public continues to understand the trademark term *primarily as a source identifier*, the particular producer is *exclusively entitled to benefits flowing from the mark's sales appeal*.²

Thus, "[t]he trademark can be a potent weapon in the competitive contest, for it guarantees, identifies, and sells the article to which it refers." 3 R. Callman, *Unfair Competition*,

²The owner of a widely recognized trademark cannot, however, prevent a competitor from referring to the owner's mark in the context of comparative advertising. This is so despite the benefits which the competitor reaps from the product recognition engendered by the owner's popularization, through expensive advertising, of the mark. *E.g. Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968).

Trademarks, and Monopolies § 65 at 3 (1969). But all of these legitimate trademark purposes derive ultimately from the mark's representation of a single fact: the product's source. It is the source-denoting function which trademark laws protect, and nothing more. See *Smith v. Chanel, Inc.*, *supra*, 402 F.2d at 566-69. The trademark is misused if it serves to limit competition in the manufacture and sales of a product. *Id.* That is the special province of the limited monopolies provided pursuant to the patent laws.

The genericness doctrine in trademark law is designed to prevent such anti-competitive misuse of trademarks. At its simplest, the doctrine states that when a trademark primarily denotes a product, not the product's producer, the trademark is lost. As we have stated, "one competitor will not be permitted to impoverish the language of commerce by preventing his fellows from fairly describing their own goods." *Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir.), *cert. denied*, 400 U.S. 916, 91 S.Ct. 174, 27 L.Ed.2d 155 (1970). Thus, the Lanham Act, enacted in 1947, provides for the cancellation of a trademark if "at any time [it] becomes the common descriptive name of an article or substance." 15 U.S.C. § 1064(c). Further, "no incontestable right shall be acquired in a mark which is the common descriptive name of any article or substance, patented or otherwise." 15 U.S.C. § 1065(4). Courts equate "common descriptive name," as used in the statute, with the shorthand expression "generic term" See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

The operation of genericness doctrine is well illustrated by the *Shredded Wheat* case, *Kellogg Co. v. National Biscuit Co.*, *supra*, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73. National Biscuit, and its predecessor, Perky, the inventor of a product which it called "Shredded Wheat," had enjoyed a patent on the manufacture of the so-named shredded, pillow-shaped, wheat biscuits from 1895 to 1912. After the patent expired, Kellogg began to manufacture an identical biscuit which it also called "Shredded Wheat." National obtained an injunction from a

district court prohibiting Kellogg's use of the trade name "Shredded Wheat." The Supreme Court reversed. It stated that once the patent on "Shredded Wheat" had expired, the right to make the product passed into the public domain. 305 U.S. at 118, 59 S.Ct. 109. It said further: As Kellogg Company had the right to make the article, it had, also, the right to use the term by which the public knows it." *Id.* at 116-17, 59 S.Ct. at 113.

National contended that even if the public did use the term "Shredded Wheat" generically, to denote an article, National nevertheless had "the exclusive right to the name 'Shredded Wheat,' because those words [had] acquired the 'secondary meaning' of shredded wheat made at Niagara Falls by [National's] predecessor." *Id.* at 118, 59 S.Ct. at 113. The Court rejected this argument, saying:

There is no basis here for applying the doctrine of secondary meaning. The evidence shows only that due to the long period in which the plaintiff or its predecessor was the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff's factory at Niagara Falls. But to establish a trade name in the term "shredded wheat" the plaintiff must show more than a subordinate meaning which applies to it. *It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer.* This it has not done. The showing which it has made does not entitle it to the exclusive use of the term shredded wheat, but merely entitles it to require that the defendant use reasonable care to inform the public of the source of its product.

Id. at 118-19, 59 S.Ct. at 113-14 (emphasis supplied).

The Court also stated:

Kellogg Company is undoubtedly sharing in the goodwill of the article known as "Shredded Wheat"; and thus is sharing in a market which was created by the skill and judgment of plaintiff's predecessor and has been widely extended by vast expenditures in advertising persistently made. But that is not unfair. Sharing in the goodwill of an

article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested. There is no evidence of passing off or deception on the part of the Kellogg Company; and it has taken every reasonable precaution to prevent confusion or the practice of deception in the sale of its product.

Id. at 122, 59 S.Ct. at 115 (footnote omitted).

The genericness doctrine has undergone little change since the *Shredded Wheat* case.³ Thus, the MONOPOLY trademark is valid only if “the primary significance of the term in the minds of the consuming public is not the product but the producer.” *Id.* at 118, 59 S.Ct. at 113. Even if only one producer—Parker Brothers—has ever made the MONOPOLY game, so that the public necessarily associates the product with that particular producer, the trademark is invalid unless source identification is its primary significance. *Id.*

One way courts have analyzed genericness is to ask whether a term “has come to be understood as referring to the genus of which the particular product . . . is a species.” *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, *supra*, 537 F.2d at 9. The distinction is between a broad classifying term—the genus—and a specific subclassifier—the species. As a hypothetical example, suppose several manufacturers produce game equipment for playing chess. Chessco’s chess game is called EN PASSANT. When a

³ See, e.g., *Helene Curtis Industries, Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1332 (7th Cir. 1977) (en banc), *cert. denied*, 434 U.S. 1070, 98 S.Ct. 1252, 55 L.Ed.2d 772 (1978); *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 580 (2d Cir. 1963); *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910, 83 S.Ct. 253, 9 L.Ed.2d 170 (1962); *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655, 666 (7th Cir. 1955); *Nissen Trampoline Co. v. American Trampoline Co.*, 193 F. Supp. 745, 748-49 (S.D.Iowa 1961).

consumer has available in his vocabulary the broad classifier "chess," but instead asks for EN PASSANT, we can infer that the consumer wants the "species" of chess equipment produced by Chessco. The consumer may have innumerable reasons for desiring EN PASSANT chess equipment: *e.g.*, price, style, durability, consistency of quality, goodwill engendered by a catchy commercial jingle, or simply a liking for the sound of the trademark. But these desired characteristics are all source-particular, in that they correlate with a given producer, Chessco. The consumer thus uses the term EN PASSANT exactly as a trademark should be used—to enable him to recognize and ask for a particular producer's chess equipment. Moreover, Chessco benefits precisely as a producer should from a trademark: it reaps profits from consumer goodwill—both as to quality of its goods and attractiveness of its advertising—associated with its unique personality in the marketplace. It is important to recognize that the species term EN PASSANT subcategorizes only as to source. For trademark genericness purposes, it is the source-denoting function of EN PASSANT which causes us to call EN PASSANT a species instead of a genus.

A genus, in contrast to a species, is a product category including essentially interchangeable⁴ goods made by unique producers. To the extent the goods within the genus differ, their distinguishing characteristics are primarily source-

⁴ Drawing upon antitrust law, Professor McCarthy has suggested that a genus or product category can be defined as including commodities for which " 'there is a cross-elasticity of demand,' " *i.e.*, that are " 'reasonably interchangeable by consumers for the same purpose.' "

1 J. McCarthy, *Trademarks and Unfair Competition*, § 12:8 at 418 (1973) (quoting *United States v. E. I. DuPont de Nemours & Co.*, 351 U.S. 377, 394-95, 76 S.Ct. 994, 100 L.Ed. 1264 (1956)). If used, cross-elasticity of demand analysis, like the genus-species distinction itself, should focus upon consumer perception of product interchangeability.

particular, *e.g.*, price, quality, and advertising jingle. When, in the consumers' minds, the characteristics which distinguish a particular product are no longer primarily source-particular, that product becomes its own genus, and its name becomes a generic name. See *Dixie Rose Nursery v. Coe*, 76 U.S.App.D.C. 371, 372, 131 F.2d 446, 447 (D.C.Cir.), *cert. denied*, 318 U.S. 782, 63 S.Ct. 856, 87 L.Ed. 1149 (1942). See also *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir.), *cert. denied*, 299 U.S. 601, 57 S.Ct. 194, 81 L.Ed. 443 (1936), 304 U.S. 575, 58 S.Ct. 1047, 82 L.Ed. 1539 (1938); *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

For example, to some consumers, EN PASSANT may be so different from most manufacturers' versions of chess that it is a wholly different game. As an example, suppose Chessco's EN PASSANT board has 81 instead of 64 squares. When a consumer calls for EN PASSANT, he may now be using the term EN PASSANT to describe game-relevant, but source-irrelevant, characteristics. That is, he wants EN PASSANT because it is a more interesting, longer, game than regular chess, not because Chessco's board is more durable, stylized, cheaper, or consistent as to quality compared to other chess boards. To this consumer, EN PASSANT has become a unique game and he uses the words EN PASSANT primarily to describe a game played with 81 squares, not to describe who makes the game equipment. We thus cannot infer from the consumer's asking for EN PASSANT any preference as to the production source of the desired game. Where before there was only one relevant product category or genus, chess, there are now two: chess and EN PASSANT. If Chessco wants to monopolize this product category, it may do so through a patent, but not through a trademark. In trademark genericness parlance, EN PASSANT has evolved from a species to a genus.

Once the genus-species distinction, or genericness doctrine, is properly understood as reflecting consumer usage of a particular term, a court is prepared to ask the crucial question: whether consumers who ask for EN PASSANT are seeking

the product of a particular producer (species), or are simply describing the product itself (genus)? Source identification is the only word function which trademark law is designed to protect. If the primary significance of the trademark is to describe the type of product rather than the producer, the trademark has become a generic term and is no longer a valid trademark.

On at least two occasions courts have invalidated a trademarked name of a game on genericness grounds. In *Selchow & Righter Co. v. Western Printing & Lithographing Co.*, 47 F.Supp. 322, 326 (E.D. Wis. 1942), *aff'd*, 142 F.2d 707, 709 (7th Cir.), *cert. denied*, 323 U.S. 735, 65 S.Ct. 75, 89 L.Ed. 589 (1944),⁵ the court, applying the "primary significance" test, found:

The plaintiff here has proved that buyers for large department stores and other like establishments have for years associated the name "Parchessi" with the plaintiff company. But that does not hold true as to the general public, for it is very evident that an ordinary customer, going into a store and asking for the game "Parcheesi", has no information as to who might have manufactured and produced that game. Not one purchaser in a thousand would know or care whether Selchow and Righter Company was the manufacturer. The fact is that the public in general knows "Parcheesi" as a game and not as an article made by the plaintiff.

In *Golomb v. Wadsworth*, 592 F.2d 1184, 201 U.S.P.Q. 200, 201 (Cust. & Pat. App. 1979), the Court of Customs and Patent Appeals, in affirming the cancellation of the trademarked names POLYOMINOES and PENTOMINOES for domino-

⁵ A prior case concerning the PARCHEESI mark, *Selchow v. Chaffee & Selchow Mfg. Co.*, 132 F. 996 (S.D.N.Y. 1904), *appeal dismissed*, 140 F. 989 (2d Cir. 1905), is also instructive. There, the court declared the PARCHEESI mark invalid because it already signified the name of a game in the Indian language when registered as a mark in the United States.

like game pieces, quoted from the Trademark Trial and Appeal Board's decision as follows: "these terms . . . have become words of art in the field of mathematical puzzles and *do not and cannot serve to designate origin in anyone* producing and selling a game which involves finding ways to fit together various shapes or configurations composed of numbers of connected squares." (Emphasis in original.) These decisions illustrate that when members of the consuming public use a game name to denote the game itself, and not its producer, the trademark is generic and, therefore, invalid.⁶

B. The District Court's Findings

The district court found as a fact that a small group of related people had played "Monopoly" in various parts of the country

⁶ In a third case, *H. B. Chaffee Mfg. Co. v. Selchow*, 131 F. 543 (S.D.N.Y. 1904), *aff'd*, 135 F. 1021 (2d Cir. 1905), the court held that when the inventor of a card game "Flinch" failed to trademark its name, no one else could, by simply manufacturing the selling "Flinch" for a long period, obtain that name as a trademark. *Id.* at 545. The court stated:

The general rule is that the generic name of a thing is not the subject of a trade-mark . . . If chess or golf or whist were now invented and named, could any manufacturer or vendor of the implements with which such games are played obtain a trade-mark in their names by selling such implements put up in boxes marked with the names of the games? He, of course, could adopt a trademark to distinguish the chessmen or the playing cards or the golf clubs which he made from those made by others, but I think he could not acquire a trade-mark in the names of the games by simply selling the games after they had become known to the public under such names.

Id. at 545-46. Although factually distinguishable, the "Flinch" case exemplifies the analysis used herein: that a trademark which the public uses primarily to denote the name of a game, rather than a producer, is generic.

Various other courts have mentioned, without deciding, the question whether the name of a game is a generic term. *See, e.g., Selchow*

before Parker Brothers registered the MONOPOLY trademark. This, the court concluded, was "insufficient to prove that the term was the common descriptive name of all real estate trading games." Thus, the court held that MONOPOLY was not a generic term prior to registration.

The district judge also held that MONOPOLY had not become, since registration, a generic name. He first stated: "This assertion [that MONOPOLY is generic] contemplates a finding that the term monopoly now refers to all real estate trading board games and not to an individual game emanating from a single source." The court then found:

The primary significance of MONOPOLY in this context is not that it describes all board trading games involving real estate trading but rather that it is the title of a particular and very popular board game produced by a single company. The public's understanding is that a particular game is called MONOPOLY and that game is produced by a single manufacturer.

Anti-Monopoly contends that neither of the district court's findings on genericness responded to the crucial issue regard-

& Righter Co. v. McGraw-Hill Book Co., 580 F.2d 25, 28 (2d Cir. 1978) ("The extent to which [SCRABBLE] has come into general use to describe a game or games rather than their origin our source of supply is fairly open to proof"; thus, plaintiff, owner of SCRABBLE mark, was entitled to a preliminary injunction to prevent the mark's dilution, pending judicial resolution of SCRABBLE's validity as a trademark); *Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 1186, 1188-89 (2d Cir. 1975) (finding consideration for settlement agreement in possibility, strongly intimated by the district judge, that game name CARROM invalid); *Application of Cooper*, 254 F.2d 611, 614-17, 45 CCPA 923, cert. denied, 358 U.S. 840, 79 S.Ct. 63, 3 L.Ed.2d 75 (1958) (holding a book title generic, because as the book's name it performs a product-denoting, not source-denoting function; observing that Patent Office may be registering names of games erroneously; and stating that if trademarked name of game is its only possible descriptive name, mark is generic).

ing the validity of the MONOPOLY mark: whether Monopoly originally denoted or now denotes primarily the name of a game, or rather a game's producer. In its proposed findings of fact and conclusions of law, Anti-Monopoly had properly presented this precise issue when it urged the court to decide that

[d]espite the efforts of defendant to police its mark, the primary significance today of MONOPOLY is, in the minds of the consuming public, the name of a game itself, and does not stand for the producer thereof. MONOPOLY has become a generic term, the name of a game, and cannot serve as a trademark.

Anti-Monopoly claims that the district court erred because it failed to make the proposed finding. It contends that the district court picked the wrong genus—all board games involving real estate trading—for determining genericness, and thus obscured the basic issue: whether MONOPOLY primarily describes a product, or a producer.

We agree that the district court erred in focusing on whether the primary significance of MONOPOLY is to denote "all board games involving real estate trading," or instead a "particular and very popular board game produced by a single company." Presumably, the district court thought that for MONOPOLY to be a generic term, it would have to describe the genus "all board games involving real estate trading." Yet, if consumers think of MONOPOLY as a unique game, and differentiate it from all other real estate trading games by source-irrelevant characteristics, *e.g.*, length of time it takes to play, or strategy involved, *MONOPOLY may constitute its own genus*. That is, the relevant product category to consumers may be the game played by the rules of "Monopoly," not all real estate trading games. Again, the crucial determination is just that requested by Anti-Monopoly: Do consumers use the term MONOPOLY *primarily to denote the product, or instead to denote its producer*? The district judge never confronted this issue, because once choosing the genus "board game involving real estate trading," he lumped together in the species category the two crucial alternative meanings: "a particular and very popular

board game" or instead a game "produced by a single company." He had to differentiate between these latter two alternatives to decide the case properly.

It may be that when a customer enters a game store and asks for MONOPOLY, he means: "I would like Parker Brothers' version of a real estate trading game, because I like Parker Brothers' products. Thus, I am not interested in board games made by Anti-Monopoly, or anyone other than Parker Brothers." On the other hand, the consumer may mean: "I want a 'Monopoly' game. Don't bother showing me Anti-Monopoly, or EASY MONEY, or backgammon. I am interested in playing the game of Monopoly. I don't much care who makes it."

In the first example, the consumer differentiates between MONOPOLY and other games according to source-particular criteria. In the second example, source is not a consideration. The relevant genus, or product category, varies accordingly. At the urging of Parker Brothers, the district court erred by first defining the genus, and then asking the "primary significance" question about the wrong genus-species dichotomy. The proper mode of analysis is to decide but one question: *whether the primary significance of a term is to denote product, or source.* In making this determination, the correct genus-species distinction, that is, the correct genericness finding, follows automatically.

We thus reverse the district court's findings as to the validity, when registered and thereafter, of the MONOPOLY trademark, and remand the case for further consideration consistent with the foregoing analysis.⁷ There is a considerable

⁷ It is significant, though not of course dispositive, that the original patent application in August 1935 divulged that "the game is known on the market as Monopoly." This usage, of course, predated any association of Parker Brothers with the game. This should be considered by the district court when analyzing whether, when registered, MONOPOLY primarily denoted the game's producer.

amount of evidence in the record bearing on consumer usage of the term MONOPOLY. It may well be, therefore, that it will be unnecessary for the district court to receive new evidence on the validity issue. That decision will be left to the district court.

III

In view of our remand on the invalidity issue, we also remand the question whether, if the MONOPOLY mark is valid, Anti-Monopoly's use thereof constitutes an infringement. The considerations affecting a determination of infringement are: the similarity in appearance, sound, and meaning of the marks, the strength or weakness of the marks, the proximity or similarity of the goods, evidence of actual confusion, the marketing channels used to market the goods, the type of goods and the degree of care likely to be exercised by the purchaser, the alleged infringer's intent in selecting the mark, and the likelihood of expansion of product lines. *E.g.*, *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); *J. B. Williams Co. v. LeConte Cosmetics, Inc.*, 523 F.2d 187, 191 (9th Cir. 1975), *cert. denied*, 424 U.S. 913, 96 S.Ct. 1110, 47 L.Ed.2d 317 (1976); *HMH Publishing Co. v. Brincat*, *supra*, 504 F.2d at 717.

We have also stated, however, that [w]hen the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are sufficiently similar that confusion can be expected.⁹

[⁹ The alleged infringer's intent in adopting the mark is weighed, both as probative evidence of the likelihood of confusion and as an equitable consideration.]

AMF, Inc. v. Sleekcraft Boats, *supra*, 599 F.2d at 348. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert denied*, 368 U.S. 820, 82 S.Ct. 36, 7 L.Ed.2d 25 (1961); *Habitat Design Holdings, Ltd. v. Habitat, Inc.*, 436 F.Supp. 327, 330-31 (S.D.N.Y. 1977), *aff'd as modified*, 573 F.2d 1290 (2d Cir. 1978) (memo.); *Bass Buster, Inc. v. Gapen*

Mfg. Co., 420 F.Supp. 144, 160 (W.D.Mo. 1976). See also *A. T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692 (2d Cir. 1972). Cf. *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 799-802 (9th Cir. 1970) (court states that "[n]umerous factors can and often do play a role in the determination of likelihood of confusion," *id.* at 800, but focuses analysis on evidence of actual confusion, and similarity of the marks in question).

Obviously, we cannot adequately review the district court's determinations, particularly as to the "similarity of meaning" and "competition" factors, without benefit of a finding whether the primary significance of MONOPOLY is to denote the name of a unique game, or instead the game's source. We do point out, however, that even if the district judge should decide that MONOPOLY is generic, it must be established, consistent with the decision in the *Shredded Wheat* case, that Anti-Monopoly is taking "reasonable care to inform the public of the source of its product." *Kellogg Co. v. National Biscuit Co.*, *supra*, 305 U.S. at 119, 59 S.Ct. at 114. This issue is similar to the determinations required in finding infringement, and there is substantial evidence in the record bearing thereon. If the district court decides reasonable source-distinguishing steps are not being taken, it may enjoin the sale of "Anti-Monopoly" except upon its compliance with appropriate conditions. See *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 581 (2d Cir. 1963); *Bayer Co. v. United Drug Co.*, 272 F. 505, 514-15 (S.D.N.Y. 1921).

IV

For the reasons just mentioned, we also remand to the district court, for further findings, the state law claims. Proper resolution of both the unfair competition and dilution issues demands, in part, inquiry into the "primary significance" of the MONOPOLY mark. Although such a finding may not be dispositive, we nonetheless await a determination that takes account of this factor. We also choose to defer consideration of

Anti-Monopoly's unclean hands defense pending resolution of the aforementioned issues.

V

Anti-Monopoly's last contention is that the district judge improperly denied it a jury trial. Anti-Monopoly places heavy emphasis on the procedural history of the case with respect to its demand for a jury trial. Anti-Monopoly points out that its original complaint contained two counts for damages, as well as its count seeking equitable relief, and that Parker Brothers had originally counterclaimed for an accounting and damages. Parker Brothers later withdrew this counterclaim, and moved, without objection from Anti-Monopoly, for severance of Anti-Monopoly's two legal claims. The district judge who was originally assigned, but who subsequently recused himself from the case, ordered that Anti-Monopoly be granted a jury trial. The district judge who ultimately heard the case, however, vacated that order, concluding that since only equitable claims remained to be tried, trial to a jury would be inappropriate.

Anti-Monopoly's allegation that pre-trial maneuvering by Parker Brothers in an effort to deprive it of a jury trial somehow vitiates the equitable nature of the case is not persuasive. Anti-Monopoly cannot complain about the severance of its legal claims, for it acquiesced in that action. Anti-Monopoly has not cited any authority for the proposition that, having once asserted a claim for damages, a party may not withdraw such a claim, or that upon such withdrawal a jury trial remains appropriate although only equitable issues remain in the case. *Lee Pharmaceuticals v. Mishler*, 526 F.2d 1115 (2d Cir. 1975) (per curiam), upon which Anti-Monopoly does rely, is authority only for the proposition that when a defendant counterclaims for damages, the plaintiff's withdrawal of its own prayer for damages does not entitle it to strike the defendant's request for a jury trial in an action for common law trademark infringement. *See id.*, at 1116-17.

Anti-Monopoly apparently also contends that the district court erred in denying it a jury trial because legal issues remain to be litigated in a related antitrust action which involves the earlier-severed legal claims. We disagree. *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 79 S.Ct. 948, 3 L.Ed. 2d 988 (1959), upon which Anti-Monopoly relies heavily, held "that where both legal and equitable issues are *presented in a single case*, 'only under the most imperative circumstances . . . can the right to a jury trial of legal issues be lost through prior determination of equitable claims.'" *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 472-73, 82 S.Ct. 894, 897, 8 L.Ed.2d 44 (1962) (emphasis supplied) (footnote omitted) (quoting *Beacon Theatres, Inc. v. Westover*, *supra*, 359 U.S. at 510-11, 79 S. Ct. 948). No legal issues remained to be tried in the district court in the matter which is now before us. The first district judge plainly erred in concluding that questions relating to the validity of the MONOPOLY trademark raised legal issues, although both parties sought only equitable relief. See *Shubin v. United States Dist. Court*, 313 F.2d 250, 251 (9th Cir.), *cert. denied*, 373 U.S. 936, 83 S.Ct. 1539, 10 L.Ed.2d 690 (1963); *Robine v. Apco, Inc.*, 227 F.Supp. 512, 516-17 (S.D.N.Y. 1964), *aff'd*, 386 F.2d 267 (2d Cir. 1967). That being so, the order, vacating the earlier grant of a jury trial to Anti-Monopoly, was properly entered. *Cf. Daly v. Volpe*, 376 F.Supp. 987, 994 (W.D. Wash. 1974), *aff'd*, 514 F.2d 1106 (9th Cir. 1975).

REVERSED AND REMANDED.

APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

NO. C-74-0529 SW

ANTI-MONOPOLY, INC.,
a California corporation,

Plaintiff,

v.

GENERAL MILLS FUN GROUP, INC.,
a Nevada corporation,
Defendant-Counterclaimant.

Original Filed
Apr - 4 1977

Clerk, U.S. Dist. Court
San Francisco

OPINION AND ORDER

Plaintiff Anti-Monopoly, Inc. is a California corporation which has engaged in the business of selling a board game under the unregistered name ANTI-MONOPOLY. Plaintiff's game was created and originated by its President, Ralph Anspach, a professor of economics. A primary focus of the game is to emphasize and support the values of the competitive private enterprise system. Professor Anspach first intended to market the game under the title BUST THE TRUST, THE ANTI-MONOPOLY GAME, but became convinced that the better title was ANTI-MONOPOLY. Since the game was first marketed in December 1973, plaintiff has sold approximately 419,000 games, taking in close to one million dollars.

Defendant and Counterclaimant General Mills Fun Group, Inc. is a Nevada corporation engaged in business in California

and elsewhere throughout the world with its principal place of business in Minnesota. Parker Brothers is an unincorporated division of defendant engaged in the business, among others, of manufacturing and selling games. Parker Brothers is the owner of the registered trademark MONOPOLY, No. 326,723 which was registered with the United States Patent and Trademark Office on July 30, 1935 and No. 338,834 registered on September 15, 1936.

For over forty years, Parker Brothers has sold a real estate trading board game under the MONOPOLY trademark. Since 1935, Parker Brothers and its predecessor have sold 80 million sets of the MONOPOLY game in the United States for \$125 million. In the past ten years it has sold 24 million sets, and since 1973 its sales have approximated 80,000 sets annually. Parker Brothers has diligently and consistently promoted and policed its MONOPOLY mark, expending \$4 million in publicizing the trademark since its first use, \$2.1 million in publicizing the mark in the last ten years, and \$234,000 in publicizing expense last year. Defendant has enjoyed exclusive use of its MONOPOLY trademark for forty years, and the mark has not been used by anyone else except plaintiff for board games or otherwise except under licenses and other permission granted by Parker Brothers.

Anti-Monopoly, Inc. seeks a declaratory judgment that the trademark MONOPOLY is invalid and that the use of the name ANTI-MONOPOLY as the title for a board game does not infringe the MONOPOLY trademark. Plaintiff further seeks cancellation of the trademark MONOPOLY. Defendants and counterclaimants seek declaratory relief that MONOPOLY is a valid trademark infringed by ANTI-MONOPOLY and an injunction permanently restraining plaintiff's use of the ANTI-MONOPOLY name.

This court has jurisdiction under 28 U.S.C. § 1338 as both plaintiff's claim and defendant's counterclaim arise under the trademark laws of the United States, 15 U.S.C. § 1501 *et seq.* Pendent jurisdiction exists over defendant's counterclaim for

unfair competition and dilution of its trademark under California Business and Professions Code § 14200 et seq. and California Civil Code § 3369. Jurisdiction also exists under 28 U.S.C. § 1332 because the action is between citizens of different states and the amount in controversy exceeds \$10,000, exclusive of interest and costs.

I. VALIDITY OF THE TRADEMARK

15 U.S.C. § 1064(c) provides for cancellation of a registered trademark if it becomes the common descriptive name of an article or substance or was obtained fraudulently. Unless one of these or the other specified grounds for cancellation exist, the right to use a trademark in continuous use for five consecutive years after registration is incontestible and is conclusive evidence of the registrant's right to use the mark in commerce, 15 U.S.C. 1065 and 15 U.S.C. § 1115(b). However, incontestibility is not applicable where "the registration or incontestible right to use the mark was obtained fraudulently, 15 U.S.C. § 1115(b)(1), or the mark is "the common descriptive name of any article or substance," 15 U.S.C. § 1065(4)¹.

Plaintiff's assertion is that the MONOPOLY trademark is invalid and should be cancelled either because 1) MONOPOLY was or has become the generic or common descriptive name of an article, 2) the trademark MONOPOLY was obtained fraudulently or 3) defendant acquired the right to use the trademark by means of a fraudulently obtained patent.

1. Common Descriptive Term

An analysis of the various trademark categories and their respective entitlements to protection is necessary in order to determine whether MONOPOLY is or was a common descrip-

¹ Other grounds for cancellation and negating incontestability exist and are enumerated in 15 U.S.C. § 1115 and § 1065. However, they are not relevant to this case.

tive term. In ascending order of the protective status accorded each, they are 1) generic 2) descriptive 3) suggestive and 4) arbitrary or fanciful. *Abercrombie & Fitch Company v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976). Generic terms, those which are the common descriptive name of an article or substance, can never be registered or entitled to trademark protection. Merely descriptive terms are not accorded protection either unless they have become distinctive or have acquired secondary meaning. *HMH Publishing Co., Inc. v. Brincat*, 504 F.2d 713, 718 (9th Cir. 1974). Secondary meaning attaches to a word or phrase originally incapable of registration which has nevertheless been used so long and exclusively by a producer with regard to a product, that the word or phrase has come to mean that the article is that producer's product. 3 Callmann, *Unfair Competition, Trademarks and Monopolies*, § 77.1 (3rd Ed. 1970). *Union Carbide Corporation v. Ever-Ready, Inc.*, 531 F.2d 366 (7th Cir. 1976), *cert. denied*, 45 U.S.L.W. 3250 (October 5, 1976).

Suggestive marks, those neither exactly descriptive or truly fanciful, need not have acquired distinctiveness or secondary meaning to be validly registered. *Abercrombie & Fitch Company v. Hunting World, Inc.*, *supra* at 537 F.2d at 11. Similarly, arbitrary and fanciful marks are always entitled to protection.

MONOPOLY was not the generic or common descriptive name of an article or substance when registered. Plaintiff introduced uncontested testimony at trial that, prior to Parker Brothers' acquisition and manufacturer of the game, a real estate trading game was played in various parts of the country and that it was sometimes called "Monopoly." This, however, is insufficient to prove that the term was the common descriptive name of all real estate trading games.

This court is of the opinion that the registration of the mark MONOPOLY as applied to the real estate trading board game in question was proper. While monopoly is a common word in the economic sense, its application to a game constitutes an

unfamiliar use and is therefore arbitrary and unique. Nor is MONOPOLY in this context a mere descriptive term.² It does not describe a game playing board and its accompanying pieces. At the most, MONOPOLY is a suggestive title validly registered without the necessity of proof of secondary meaning. *Abercrombie and Fitch Company v. Hunting World, Inc.*, *supra*, 537 F.2d at 11.

Nor is the trademark MONOPOLY invalid because, although once validly registered, it has now become generic or the common descriptive name of the article. This assertion contemplates a finding that the term monopoly now refers to all real estate trading board games and not to an individual game emanating from a single source. This is not the case. MONOPOLY can be differentiated from cellophane, thermos and aspirin. *King-Seeley Thermos Co. v. Alladin Industries*, 321 F.2d 577 (2d. Cir. 1963); *DuPont Co. v. Waxed Products Co.*, 85 F.2d 75 (2d. Cir. 1936); *Bayer & Co. v. United Drug Co.*, 272 F.2d 505 (2d. Cir. 1921). The primary significance of MONOPOLY in this context is not that it describes all board

² Even if MONOPOLY were originally a merely descriptive term incapable of exclusive appropriation it has since acquired secondary meaning entitling it to protection. The evidence is insufficient to show that the development of this secondary meaning was assisted by the Darrow patent alleged by plaintiffs to have been obtained by fraud. Fraud has not been established. Furthermore, the testimony indicates that this court is persuaded that the Darrow patent was a narrow one and Parker Brothers considered the Phillips patents to be the basic patents for the MONOPOLY game. (TR 226-229, 267).

It should also be noted that when a trademark is incontestible under U.S.C. § 1065, the registrant's mark is immune from challenge on any grounds not enumerated in 15 U.S.C. § 1115(b). Therefore a descriptive term which has acquired secondary meaning or is distinctive is immune from challenge. *Union Carbide Corporation v. Ever-Ready, Inc.*, *supra*, 531 F.2d at 375-377. *But see Flavor Corporation of America v. Kemin Industries, Inc.*, 493 F.2d 275 (8th Cir. 1974).

games involving real estate trading but rather that it is the title of a particular and very popular board game produced by a single company. The public's understanding is that a particular game is called MONOPOLY and that game is produced by a single manufacturer.³ Therefore, MONOPOLY has not become "generic" or the common descriptive name of the article and the trademark remains valid.

2. Fraud in Trademark Acquisition

Plaintiff's second ground for cancellation, that the trademark was acquired by fraud, also lacks merit. Fraud requires a false statement "made in bad faith with a fraudulent purpose and intent to secure a registration by deception." *National Tuberculosis Ass'n. v. Summit Country Tuberculosis Health Ass'n.*, 122 F. Supp. 654, 658 (N.D. Ohio, 1954). Plaintiff's counsel in closing argument admitted that fraud in obtaining the MONOPOLY trademark had not been established. This court agrees. The evidence does not show that Robert B. M. Barton, the former President of Parker Brothers, made false statements to the Patent Office in bad faith in obtaining the original MONOPOLY trademark registration.

II. INFRINGEMENT

15 U.S.C. § 1114(1) creates a cause of action for trademark infringement if there is a likelihood of confusion as to the source of the product. Actual confusion need not be found, but there must be a strong likelihood of confusion rather than a mere possibility. Factors to be considered in determining the likelihood include:

The strength or weakness of the marks, similarity in appearance, sound, and meaning, the class of good in question, the marketing channels, evidence of actual con-

³ Plaintiff's survey evidence does not convince this court to the contrary.

fusion, and evidence of the intention of defendant in selecting and using the alleged infringing name.

J. B. Williams Co., Inc. v. LeConte Cosmetics, Inc., 523 F.2d 187, 191 (9th Cir. 1975), *cert. denied*, 424 U.S. 913 (1976). *HMH Publishing Co., Inc. v. Brincat*, 504 F.2d 713, 717 (9th Cir. 1974); *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 152 (9th Cir. 1963).

As an arbitrary or suggestive mark or as a descriptive term which has acquired secondary meaning, MONOPOLY is a strong trademark entitled to protection. This fact of association of the word MONOPOLY with the individual manufacturer means that the use of this word or phrase by another can result in a likelihood of confusion. *HMH Publishing Co., Inc., v. Brincat*, *supra*, 504 F.2d at 718.

The similarity of the two games as to product type and marketing channels is also significant in a confusion determination. These products are in direct competition. *Union Carbide Corporation v. Ever-Ready Incorporated*, *supra*, 531 F.2d at 382. Both are board games sold primarily in toy or game stores and departments. They are often stacked in close proximity to each other and the boxes are of similar size although the markings are not identical.⁴

Most troublesome is the name similarity. Plaintiff/Counter-defendant has incorporated the entire MONOPOLY mark into the name ANTI-MONOPOLY. It has not merely used part of the name or a similar but varied version. Use of the entire name MONOPOLY in the game title gives rise to an inference that the game is a variation of the MONOPOLY game and is probably produced by the same company. Contrary to plain-

⁴ Ralph Anspach indicated in his testimony that he did intend to design a unique box to be clearly distinguishable from the MONOPOLY box. (TR 133).

tiff's contention, the fact that the "anti" phrase serves as an antithetical word is insufficient to preclude a finding of similarity and confusion.

The initial refusal of the Patent Office to approve plaintiff's application to register ANTI-MONOPOLY as a trademark is also entitled to some weight. The ground for this refusal was the close resemblance to MONOPOLY and the possibility of confusion, mistake or deception. While this refusal is not conclusive evidence, particularly since plaintiff chose to not pursue the application further, it is valid cumulative evidence corroborating a finding of confusion.

A further factor to be considered in determining the existence of confusion is the alleged infringer's intent. The plaintiff in an infringement is not required to prove intent. However, where it is shown, the inference may be drawn and the burden shifts to the defendant (here plaintiff/counterdefendant) to show that his efforts were unsuccessful. *HMH Publishing Co., Inc. v. Brincat, supra*, 504 F.2d at 720. Anspach received two legal opinions that ANTI-MONOPOLY did not infringe upon the name MONOPOLY. He designed the box to be unique and different from MONOPOLY.⁵ Further, he instructed his sales staff to disassociate the game with Parker Brothers. However, the record clearly shows that Anspach felt that the best name under which his game could be marketed was ANTI-MONOPOLY rather than BUST THE TRUST. While there was no intent to specifically infringe upon the MONOPOLY trademark since a sincere belief was held that use of the name ANTI-MONOPOLY would not constitute infringement, there was clearly an intent to increase sales by the use of a popular name. Such an intent is sufficient to draw an inference of likelihood of confusion and that inference has not been rebutted by the plaintiff. *HMH Publishing Co., Inc. v. Brincat, supra*, 504 F.2d at 720.

⁵ See Footnote 4, *supra*.

The finding of a likelihood of confusion is further substantiated by the considerable amount of evidence of actual confusion introduced at trial. A number of sales clerks in toy or game stores and departments testified as to their initial confusion as to the source of ANTI-MONOPOLY. Further evidence of confusion by those in the retail trade in ordering both games and parts for the ANTI-MONOPOLY game was introduced. Instances of employees stacking the two games together under the mistaken assumption they were both produced by Parker Brothers or due to a feeling it would assist sales are indicative of the existence of confusion. These amounted to more than isolated occurrences.

This confusion on the part of store clerks and employees is not conclusive evidence of general public confusion. However, it does give rise to an inference that purchasers would also be confused. Retail sales personnel are more familiar with trademarks. If they are confused, there is an inference that the general public is likely to be confused. *Union Carbide Corporation v. Ever-Ready Incorporated, supra*, 531 F.2d at 366 (7th Cir. 1976); *Jockey International, Inc. v. Burkard*, 185 USPQ 201, 205 (S.D. Cal. 1975).

Testimony of retail store employees as to incidents of consumer confusion is also relevant. Substantiating this testimony were instances of direct letters from consumers ordering ANTI-MONOPOLY from Parker Brothers. While each of these incidents alone would not lead to a conclusion that a likelihood of confusion exists, they are cumulatively very persuasive.

Both parties to this action have also introduced survey evidence relevant to the issue of confusion. While such evidence should not be given controlling weight, defendant's finding that a minimum of 15% confusion exists as to source between MONOPOLY and ANTI-MONOPOLY corroborates the above findings. Plaintiff's survey evidence is not otherwise persuasive. The use of EASY MONEY rather than PRIZE PROPERTY as a control does not give plaintiff's data a grea-

ter degree of reliability. Furthermore, the limitation of the survey to female heads of household and to those who had never seen EASY MONEY detracts from the credibility of plaintiff's findings.

The cumulative effect of the factors articulated above leads this court to the conclusion that the use of the name ANTI-MONOPOLY as the title to plaintiff's game creates a strong likelihood of confusion in the general public as to the source of the game.

III. CALIFORNIA CLAIMS

An analysis of this case under California law of unfair competition leads to the same result. There is a strong likelihood that the public will be deceived as to the source of the ANTI-MONOPOLY game due to confusion with the mark MONOPOLY. This is sufficient to establish a claim for unfair competition under California Civil Code § 3369. *HMH Publishing Co., v. Brincat, supra*, 504 F.2d at 720 (9th Cir. 1974); *Schwartz v. Slenderella Systems*, 43 C.2d 107 (1954). Since confusion exists, plaintiff's name also dilutes defendants trademark MONOPOLY within the meaning of California Business and Professions Code § 14330. It is not necessary to decide whether § 14330 provides more extensive protection. *HMH Publishing Co., v. Brincat, supra*, 504 F.2d at 720.

IV. EQUITY

Plaintiffs contend that defendants/counterclaimants are not entitled to injunctive relief; that the court should not use its equity power to protect the MONOPOLY trademark because Parker Brothers has abused the trademark. There is nothing in the record which persuades this court that an abuse of the trademark has occurred. Nor, as discussed above, is there any evidence indicating that fraud was involved in the acquisition of the original trademark.

CONCLUSION

Parker Brothers' MONOPOLY trademark is valid and enforceable in all respects. Use of the name ANTI-MONOPOLY as the title to plaintiff's game creates a strong likelihood of confusion in the public mind and constitutes an infringement of the trademark MONOPOLY.

Parker Brothers is therefore entitled to a permanent injunction forbidding and restraining plaintiff:

- a. from using the words ANTI-MONOPOLY or MONOPOLY or any other word or words, syllable or syllables, confusingly similar to MONOPOLY, alone or in combination with any other syllable or syllables, word or words, as a trademark or trade or corporate name on or in connection with the advertising, offering for sale or sale of any board game;
- b. from committing any other acts calculated to cause purchasers to believe that plaintiff's products are products of defendant or are sponsored or put out by defendant and from otherwise competing unfairly with defendant in any manner.

Plaintiff is further ordered to deliver up for destruction any and all products, games, equipment, catalogue price lists, circulars, signs, prints, advertising, dies, plates, labels, wrappers, packaging materials, invoices, stationery and other materials in the possession or under the control of plaintiff, bearing the word ANTI-MONOPOLY as the name or trademark for any goods of plaintiff.

Parker Brothers shall have and recover from plaintiff its costs of suit.

IT IS SO ORDERED.

DATED: 4-4-77

/s/

UNITED STATES DISTRICT JUDGE

APPENDIX E

SUPREME COURT OF THE UNITED STATES

No. A-440

**GENERAL MILLS FUN GROUP, INC., and
CPG PRODUCTS CORPORATION,**

Petitioners,

v.

ANTI-MONOPOLY, INC.

**ORDER EXTENDING TIME TO FILE
PETITION FOR WRIT OF CERTIORARI**

UPON CONSIDERATION of the application of counsel for petitioner(s),

IT IS ORDERED that the time for filing a petition for writ of certiorari in the above-entitled cause be, and the same is hereby, extended to and including December 24, 1982.

/s/ William H. Rehnquist

WILLIAM H. REHNQUIST

**Associate Justice of the Supreme Court of the United
States**

Dated this 16th day of November, 1982

APPENDIX F

FEDERAL RULES OF CIVIL PROCEDURE

Rule 52. Findings by the Court

(a) **Effect.** In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

Title 15, United States Code

§ 1057. Certificates of registration

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.

§ 1064. Cancellation of registration

A verified petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed by any person who believes that he is or will be damaged by the registration of a mark on the

principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905—

(a) within five years from the date of the registration of the mark under this chapter; or

(b) within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905; or

(c) at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsections (a), (b), or (c) of section 1052 of this title for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration thereunder, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used: or

(d) at any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title; or

(e) at any time in the case of a certification mark on the ground that the registrant (1) does not control, or is not able legitimately to exercise control over, the use of such mark, or (2) engages in the production or marketing of any goods or services to which the certification mark is applied, or (3) permits the use of the certification mark for purposes other than to certify, or (4) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in subsections (c) and (e) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required.

(July 5, 1946, ch. 540, title I, § 14, 60 Stat. 433; Oct. 9, 1962, Pub. L. 87-772, § 9, 76 Stat. 771.)

§ 1065. Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under subsections (c) and (e) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of the publication under this chapter of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided, That—*

(1) there has been no final decision adverse to registrant's claim of ownership of such mark for such goods or services, or to registrant's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matter specified in subsections (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the common descriptive name of any article or substance, patented or otherwise.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Commissioner within one year after the expiration of any period of five consecutive years after the date of publica-

tion of a mark under the provisions of subsection (c) of section 1062 of this title.

The Commissioner shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

(July 5, 1946, ch. 540, title I, § 15, 60 Stat. 433; Oct. 9, 1962, Pub. L. 87-772, § 10, 76 Stat. 771; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949.)

§ 1115. Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce on the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered.

(b) If the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provision of said section 1065 subject to any conditions or limitation stated therein except when one of the following defenses or defects is established:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to registration of the mark under this chapter or publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States.

(July 5, 1946, ch. 540, title VI, § 33, 60 Stat. 438; Oct. 9, 1962, Pub. L. 87-772, § 18, 76 Stat. 774.)

§ 1122. Repealed. May 24, 1949, ch. 139, § 142, 63 Stat. 109

Section, act July 5, 1946, ch. 540, title VI, § 40, 60 Stat. 440, related to review of cases by the Supreme Court, and is now covered by section 1254 of Title 28, Judiciary and Judicial Procedure.

§ 1127. Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * * * *

The term "trade-mark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

* * * * *

A mark shall be deemed to be "abandoned"—

(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin.

The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

* * * * *

APPENDIX G

Registered July 30, 1935

Renewed for 20 years from July 30, 1955

Pub. (Sec. 12 c) on July 20, 1948

COMB. AFF. SEC. 8 & 15

UNITED STATES PATENT OFFICE

Trade-Mark 326,723

Parker Brothers, Inc., Portland, Maine, and Salem, Mass.

Act of February 20, 1905

Application March 30, 1935, Serial No. 363,230

MONOPOLY STATEMENT

To all whom it may concern:

Be it known that Parker Brothers, Inc., a corporation organized under the laws of the State of Maine, located at Portland, Maine, and having its principal place of business at 190 Bridge Street, Salem, county of Essex, State of Massachusetts, has adopted and used trade-mark shown in accompanying drawing, for a BOARD GAME PLAYED WITH MOVABLE PIECES, in Class 22, Toys, games, and sporting goods.

The trade-mark has been continuously used and applied to said goods in applicant's business since March 20, 1935.

The trade-mark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trade-mark is shown.

PARKER BROTHERS, INC.,
By ROBERT B. M. BARTON,
President.

Amendment

Registered July 30, 1935

Registration No. 326,723

Parker Brothers, Inc.

Application to amend having been made by Parker Brothers, Inc., owner of the registration above identified, said registration is hereby amended as follows:

In the statement, column 1, lines 7 and 8, "a board game played with movable pieces" is deleted and *equipment comprising a board and movable pieces for use in playing a real estate trading game* is inserted.

Such amendment has been entered upon the records of the Patent Office and the said original registration should be read as so amended.

Signed and sealed this 26th day of May 1959.

[SEAL]

Maurice A. Crews,
MAURICE A. CREWS,
Assistant Commissioner of Patents.

APPENDIX H

Registered Sept. 15, 1936

Renewed for 20 years from Sept. 15, 1956

Pub. (Sec. 12 c) on Oct. 4, 1955

UNITED STATES PATENT OFFICE

Trade-Mark 338,834

Parker Brothers, Inc., Portland, Maine, and Salem, Mass.

Act of February 20, 1905

Application March 28, 1936, Serial No. 376,540

MONOPOLY STATEMENT

To all whom it may concern:

Be it known that Parker Brothers, Inc., a corporation organized under the laws of the State of Maine, located at Portland, Maine, and having its principal place of business at 190 Bridge Street, Salem, county of Essex, State of Massachusetts, has adopted and used trade-mark shown in accompanying drawing, for TOY MONEY AND RACKS AND TILLS SUITABLE FOR HOLDING SAME FOR USE IN THE PLAY OF GAMES, in Class 22, Games, toys, and sporting goods.

The trade-mark has been used continuously and applied to said goods in applicant's business since March 20, 1935, the applicant's being the owner of trade-mark No. 326,723 registered July 30, 1935. The trade-mark is applied by the use of a

label bearing the mark "Monopoly" upon the individual packages of goods as supplied to the dealer.

PARKER BROTHERS, INC.,
By DONALD B. JELLY,
Vice President.

Attest: Apr. 8 1974

/s/ E. I. Williams
E. I. WILLIAMS
Attesting Officer

CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION, WHICH IS IN FULL FORCE AND EFFECT, WITH NOTATION OF ALL STATUTORY ACTIONS TAKEN THEREON, AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT OFFICE. SAID RECORDS SHOW TITLE TO THE REGISTRATION IN General Mills Fun Group, Inc., a Nevada corp.

/s/ C. Marshall Dann
C. MARSHALL DANN
Commissioner of Patents

E.T.

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